FILE COPY

NOV 18 1949

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1949

No. 460

JIFFY LUBRICATOR COMPANY, INC.,
Plaintiff-Petitioner,

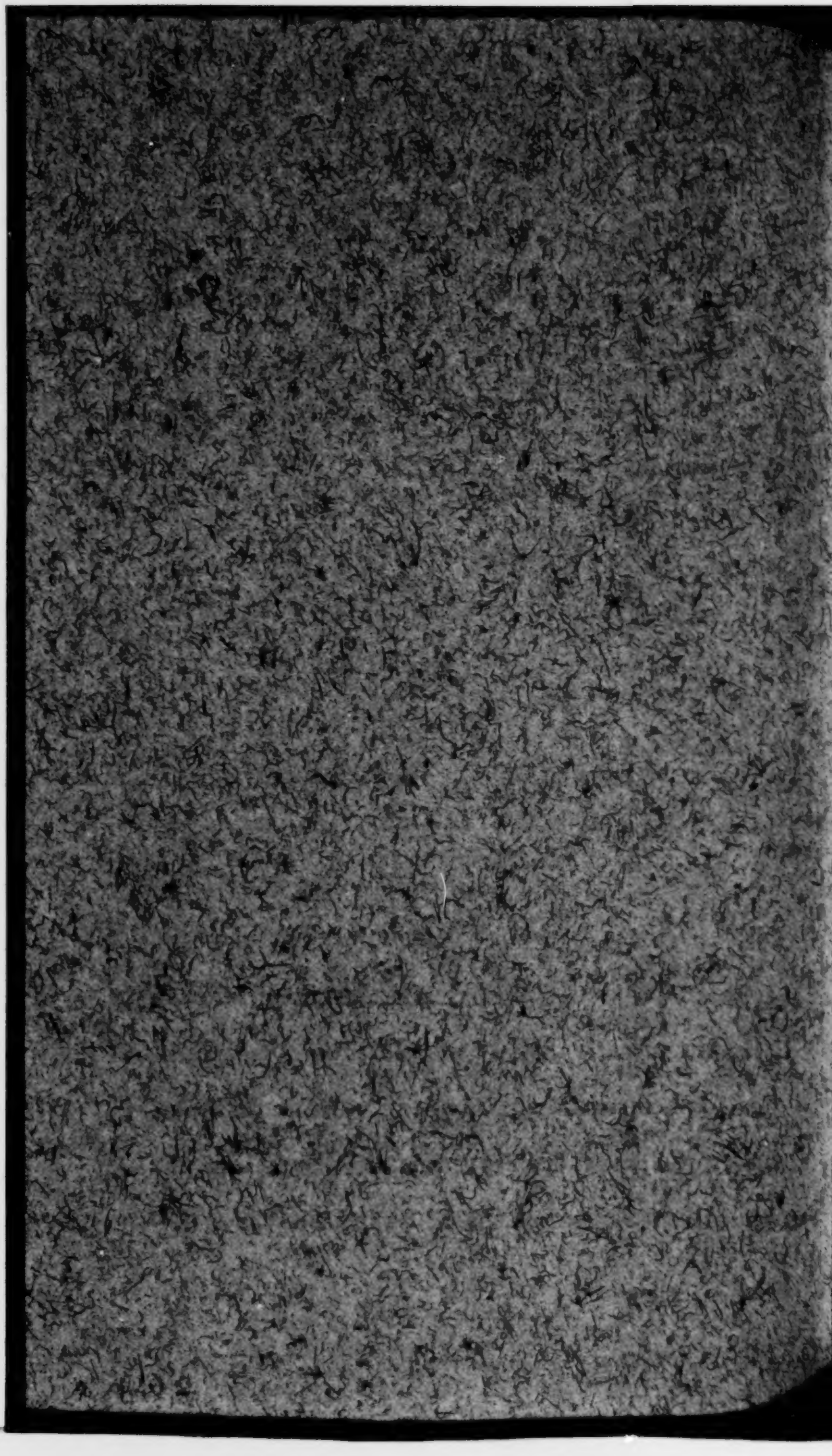
vs.

STEWART-WARNER CORPORATION,
Defendant-Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT OR, IN THE ALTERNATIVE, MOTION FOR LEAVE TO FILE PETITION FOR WRIT OF MANDAMUS OR CERTIORARI.

LEONARD L. KOSSER,
Land Title Building,
Philadelphia 10, Pa.

LAWRENCE M. WOODSIDE,
WOODSIDE, MORGAN & HAMMOND,
1001 E. Main Street,
Richmond 19, Virginia,
Attorneys for Petitioner.



INDEX

	Page
Petition	1-2
Summary and Short Statement of the Matter Involved	2-10
Nature of the Suit	2
Proceedings in the District Court	3-9
Proceedings in the Court of Appeals	9-10
Jurisdiction	10-11
Questions Involved	11-13
Reasons Relied On for Allowance of Writ	13-21
Reason 1	13
Authorities in support of Reason 1	13
Reason 2	13-15
Authorities in support of Reason 2	14-15
Reason 3	15-16
Authorities in support of Reason 3	16
Reason 4	16-20
Authorities in support of Reason 4	17-20
Reason 5	20-21
Authorities in support of Reason 5	20-21
Conclusion	21
Counsel's Certificate	22

Table of Cases Cited

Alemite Corp. v. *Grease-Rite Corp.*, not reported (DC ND Ill., Eq. No. 9812)	7, 19
Alemite Corp. v. *Jiffy Lubricator Company, Inc.*, 176 F. 2d 444 (CA-8)	4, 8
Auburn Capitol Theatre Corp. v. *Schine Chain Theatres*, 83 F. Supp. 872 (DC SD NY)	18
Bassick Manufacturing Company v. *R. M. Hollingshead Company*, 298 U. S. 415, 80 L. Ed. 1251	20
Bolton v. *General Motors Corp.*, 81 F. Supp. 851, 852 (DC ND Ill)	19
Brown v. *Insurograph*, 85 F. Supp. 328, 330-1 (DC Del.)	18, 19

Page

Canadian Pacific Ry. Co. v. *Sullivan*, 126 F. 2d 433, 439-40 (CCA 1) certiorari denied 316 U. S. 696, 86 L. Ed. 1766 18

Chesapeake & Ohio Ry. Co. v. *Kaltenbach*, 124 F. 2d 375 (CCA 4) 8, 19

Collett, Ex parte, 337 U. S. 55, 93 L. Ed. 901 ..... 13, 14, 20

Douglas v. *Cunningham*, 294 U. S. 207, 209, 79 L. Ed. 862, 864 ..... 13, 14, 16, 17

Enelow v. *New York Life Insurance Co.*, 293 U. S. 379, 381, 383, 79 L. Ed. 440, 442-3 16

Ettelson v. *Metropolitan Life Insurance Co.*, 317 U. S. 188, 191-2, 87 L. Ed. 176, 178-9 16

Faulkner v. *Gibbs*, 338 U. S. —, 94 L. Ed. 30, 83 U.S. P.Q. 192 ..... 14, 16, 17

Gilbert v. *Gulf Oil Corp.*, 153 F. 2d 883 (CCA 2); reversed on other grounds 330 U. S. 501, 91 L. Ed. 1055 15

Gulf Oil Corp. v. *Gilbert*, 330 U. S. 501, 508, 91 L. Ed. 1055, 1062 18

Hoeltke v. *C. M. Kemp Mfg. Co.*, 80 F. 2d 912 (CCA 4); certiorari denied 298 U. S. 673 ..... 8, 19

International Milling Co. v. *Columbia Transportation Co.*, 292 U. S. 511, 521, 78 L. Ed. 1396, 1401-2 18

Jungerson v. *Ostby and Barton Co.*, 335 U. S. 560, 93 L. Ed. 232, 234 ..... 14, 18

Kilpatrick v. *Texas & Pacific Railway Co.*, 337 U. S. 75, 93 L. Ed. 912 ..... 13, 20

Koster v. *Lumbermen's Mutual Casualty Co.*, 153 F. 2d 888 (CCA 2); affirmed 330 U. S. 501, 91 L. Ed. 1055 15

Levenson v. *Little*, 81 F. Supp. 513, 517 (DC SD NY) 19

Lincoln Engineering Co. v. *Stewart-Warner Corp.*, 91 F. 2d 757 (CCA 7); reversed at 303 U. S. 545, 82 L. Ed. 1008 ..... 7, 19

Lincoln Engineering Company of Illinois v. *Stewart-Warner Corporation*, 303 U. S. 545, 82 L. Ed. 1008 ..... 5, 19

Los Angeles Brush Mfg. Corp. v. *James*, 272 U. S. 701, 706, 708, 71 L. Ed. 481, 483, 484 ..... 16, 21

Page

Mandel Bros. v. *Wallace*, 335 U. S. 291, 93 L. Ed. 11, 12 ..... 14, 18

McClellan v. *Carland*, 217 U. S. 268, 280, 54 L. Ed. 762, 766 20

Paramount Publix Corp. v. *American Tri-Ergon Corp.*, 294 U. S. 477, 79 L. Ed. 1005; 293 U. S. 587, 79 L. Ed. 682; 293 U. S. 528, 79 L. Ed. 638 18

Perry v. *Atchison, T. & S. F. Ry. Co.*, 82 F. Supp. 912, 913 (DC ND Cal.) 19

Porta v. *Watts*, 109 F. 2d 966, 969 (CCA 10) 15

Rogers v. *Alemite Corporation*, 298 U. S. 415, 80 L. Ed. 1251 20

Schriber-Schroth Co. v. *Cleveland Trust Co.*, 305 U. S. 47, 50, 83 L. Ed. 34, 36 18

Simons, Matter of, 247 U. S. 231, 239-240, 62 L. Ed. 1094, 1096 ..... 16, 21

Skinner & Eddy Corp., Matter of, 265 U. S. 86, 95-96, 68 L. Ed. 912, 915 21

Stewart-Warner Corp. v. *Jiffy Lubricator Company, Inc.*, 81 F. 2d 786 (CCA 8) 8

Stewart-Warner Corp. v. *LeVally*, 15 F. Supp. 571 and 16 F. Supp. 778 and 31 U.S.P.Q. 195 (DC ND Ill.) 5, 7, 19

Stewart-Warner Corporation v. *Lincoln Engineering Co. of Illinois*, 91 F. 2d 757 (CCA 7), reversed 303 U. S. 545 ..... 5, 7

United States, Ex parte, 287 U. S. 241, 246, 77 L. Ed. 283, 285 21

United States v. *National City Lines*, 337 U. S. 78, 93 L. Ed. 914, 915 ..... 13, 15, 20

Williams v. *Green Bay & Western R. Co.*, 147 F. 2d 777 (CCA 2); reversed on other grounds 326 U. S. 549, 90 L. Ed. 311 15

Williams v. *Green Bay & Western R. Co.*, 326 U. S. 549, 554, 559-560, 90 L. Ed. 311, 315, 318 18

Statutes Cited

United States Code:

	Page
Title 28, Section 109 (Section 48 of the Judicial Code)	10
Title 28, Section 1254(1)	10
Title 28, Section 1291	9, 11, 14, 20
Title 28, Section 1292(1)	9, 12, 15, 16, 20
Title 28, Section 1404(a)	2, 3, 11, 13, 14, 15, 18, 20
Title 35, Section 67 (Section 4919 of the Revised Statutes)	10
Title 35, Section 70 (Section 4921 of the Revised Statutes)	10

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1949

No. 460

JIFFY LUBRICATOR COMPANY, INC.,
Plaintiff-Petitioner,

vs.

STEWART-WARNER CORPORATION,
Defendant-Respondent

PETITION FOR WRIT OF CERTIORARI OR, IN THE ALTERNATIVE, MOTION FOR LEAVE TO FILE PETITION FOR WRIT OF MANDAMUS OR CERTIORARI.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your Petitioner, Jiffy Lubricator Company, Inc., respectfully prays for a writ of certiorari to review the decision (R. pp. 123-126; reported at — F. 2d —, 83 USPQ 144), and judgment (R. p. 126) of the United States Court of Appeals for the Fourth Circuit, rendered in this case on October 10, 1949 which appellate decision, *inter alia,* dis-

missed petitioner's appeal (R. p. 73) from the order (R. p. 72) of the United States District Court for the Eastern District of Virginia (dated July 29, 1949) granting defendant's motion under Section 1404(a) of Title 28, United States Code, and directing transfer of this action to the United States District Court for the Northern District of Illinois, Eastern Division,

or, in the alternative,

respectfully moves for leave to file a petition for a writ of mandamus or certiorari requiring vacation of the aforesaid District Court's order dated July 29, 1949 (directing transfer of this action to the United States District Court for the Northern District of Illinois, Eastern Division).

A certified transcript of the record in this case, including the proceedings in said Court of Appeals as well as in said District Court, is furnished herewith, in accordance with Rule 38 of this Court.

Summary and Short Statement of the Matter Involved

Nature of the Suit

The complaint (R. pp. 1-20) at bar was filed in the United States District Court for the Eastern District of Virginia, on July 23, 1948, by your petitioner, Jiffy Lubricator Company, Inc. (a North Dakota corporation, and a citizen, resident and inhabitant of the State of North Dakota), against defendant-respondent Stewart-Warner Corporation (a *Virginia corporation and a resident and inhabitant of the Eastern District of Virginia*) for damages, including general damages, sustained by plaintiff in consequence of defendant's infringement of Johnson patent 2,040,177, granted May 12, 1936 to petitioner, and for petitioner's reasonable attorney's fees, costs, and for interest.

Proceedings in the District Court

On August 12, 1948, before answer filed, defendant [1] filed a motion to require plaintiff to file security for costs, and, on the same date (namely on August 12, 1948) defendant filed another motion to strike the complaint in its entirety. In its last-mentioned motion, defendant moved that its time for answering or otherwise pleading to the complaint be extended for a period of 30 days from the disposition of its two motions.

On December 1, 1948 the District Court, upon defendant's motion, entered an order continuing defendant's aforesaid two motions generally.

After the defendant had so invoked the jurisdiction of the District Court, and while its aforesaid two motions still remained unargued and undecided, defendant filed a motion (R. p. 21) under Section 1404(a) of Title 28, United States Code, for entry of an order transferring the case from the United States District Court for the Eastern District of Virginia to the United States District Court for the Northern District of Illinois, Eastern Division. In support of this motion, defendant submitted an affidavit (R. pp. 21-25) of its president, James S. Knowlson, and an affidavit (R. pp. 26-28) of one of its attorneys, John D. Black, Esq.

In the Knowlson affidavit, it was alleged that the offices and principal factory of defendant were located in Chicago, Illinois; that defendant's "Alemite" hydraulic couplers charged to infringe your petitioner's Johnson patent 2,040,177 were manufactured in, and distributed from, Chicago where the books and records of defendant were kept;

---

[1] defendant-respondent (which, as pointed out above, is a Virginia corporation and a resident and inhabitant of the Eastern District of Virginia and which has its statutory office and agent within the Eastern District of Virginia), has not questioned the jurisdiction of the District Court for the Eastern District of Virginia and has not questioned the sufficiency of the service upon it.

that defendant's officers, employees and most of defendant's witnesses were located in Chicago, and that defendant had retained Chicago counsel to represent it in this suit.

In the Black affidavit, it was alleged that affiant had participated in two trials wherein counsel for your petitioner had demanded production of much correspondence and other records requiring considerable work to produce and that it was his (Black's) opinion that there would be a demand, in the case at bar, for the production of many witnesses, papers, documents and records located in Chicago.

In opposition to defendant's motion to transfer this case to the Northern District of Illinois, Eastern Division, your petitioner filed an affidavit (R. pp. 61-64) of its president, August Johnson and an affidavit (R. pp. 41-53) of its principal attorney, the undersigned Leonard L. Kalish, of Philadelphia.

The Johnson affidavit referred to the action entitled *Jiffy Lubricator Company, Inc.* v. *The Alemite Company* (in the U. S. District Court for the District of North Dakota); wherein plaintiff-petitioner had brought suit against Stewart-Warner Corporation's distributor (The Alemite Company), seeking, *inter alia,* damages for infringement of Johnson patent 2,040,177, here in suit; and wherein the jury had found the patent valid and infringed by The Alemite Company's sale of the aforesaid "Alemite" hydraulic couplers manufactured by Stewart-Warner Corporation; and wherein the District Court had denied defendant's motions for Judgment N.O.V. and for a new trial [2] and had entered judgment [3] in favor of your petitioner for the

---

[2] and stated in his Opinion on defendant's motion, that in his opinion, too, the hydraulic coupler of petitioner's Johnson patent in suit involved invention over the prior-art, was patentable and was infringed by defendant's "Alemite" hydraulic coupler.

[3] since reversed by the Court of Appeals for the Eighth Circuit (solely on the question of the validity of the patent) in a decision dated August 17, 1949 (reported at 176 F. 2d 444); and petition for re-hearing (R.

amount of the jury's verdict and for costs and interest (totaling $23,840.53).

The Johnson affidavit (R. 62) pointed out that, in the North Dakota suit, Stewart-Warner Corporation [4] had admitted its participation in the defense of the North Dakota suit and its payment of most of the expenses incident to the defense of the North Dakota suit, insofar as the suit was for infringement of your petitioner's Johnson patent 2,040,177 (R. pp. 16-20).

The Johnson affidavit further quoted (R. pp. 62-63) from the Answer in the North Dakota suit, wherein reliance was placed upon decision of the U. S. Court of Appeals for the 7th Circuit in *Stewart-Warner Corporation* v. *Lincoln Engineering Co. of Illinois*, 91 F. 2d 757 (which decision was *reversed* by this Court in *Lincoln* v. *Stewart-Warner*, 303 U. S. 545).

To the Johnson affidavit was annexed a photostatic copy of a portion of The Alemite Company's Brief (R. pp. 64-71) on Appeal to the Eighth Circuit in the North Dakota suit, from which it is evident that The Alemite Company and Stewart-Warner Corporation relied heavily upon the decisions [5] of the courts of the Seventh Circuit (favorable to them), which decisions were reversed by this Court in *Lincoln* v. *Stewart-Warner*, 303 U. S. 545.

By way of answer to the Black affidavit, the Kalish affidavit pointed out

> that the "considerations of convenience" alleged by Stewart-Warner Corporation in support of its Motion

pp. 78-122) denied on October 31, 1949, and as to which your petitioner is filing a petition in this Court for writ of certiorari.

[4] which had been named the defendant in the North Dakota action but as to which the Complaint had been dismissed for lack of jurisdiction, upon Stewart-Warner Corporation's motion (the District Court having ruled that Stewart-Warner Corporation was not found within the District of North Dakota).

[5] 15 F. Supp. 571 and 16 F. Supp. 778 and 31 U.S.P.Q. 195 and 91 F. 2d 757.

to Transfer this case to the Northern District of Illinois, Eastern Division, were not sound because many of the books and records had already been photostated or otherwise reproduced in connection with previous litigation and could be produced equally well at Richmond as at Chicago (R. pp. 49-50),

that the evidence of such officers and employees of Stewart-Warner Corporation whose testimony might be required could be taken by way of deposition in Chicago without the need for their being brought to Richmond (R. p. 43),

that the requested transfer of this action would be highly prejudicial to your petitioner on important points of substantive law involving petitioner's Johnson patent 2,040,177, in suit (R. pp. 43-44),

that it was Stewart-Warner Corporation's lack of cooperation and its delaying tactics and refusal to permit photostating of its records in Chicago that ultimately required the production of such records in suits tried in other cities, and that copies of much of Stewart-Warner Corporation's pertinent correspondence, etc. had theretofore been delivered into the custody of the Clerk of the District Court for the District of North Dakota so that they would be as readily available in Richmond as in Chicago (R. pp. 45-49),

that, in the North Dakota suit,[6] both Stewart-Warner Corporation and The Alemite Company refused to produce material called for by plaintiff *prior to trial*, but did produce such material at the trial, and that only a very small number of papers were needed or produced at the trial (R. pp. 50-51),

that *not a single* officer or employee of Stewart-Warner Corporation appeared at the trial (R. p. 51),

---

[6] which was tried for 13 days with 2869 pages of transcript of testimony and trial-proceedings.

that, while many depositions were taken in different cities in connection with the North Dakota suit, *not a single* deposition had been taken in Chicago (R. p. 52),

that the decisions of the Court of Appeals [7] for the 7th Circuit and particularly of the District Court [8] for the Northern District of Illinois, Eastern Division, have been unfavorable to your petitioner's position and favorable to the position asserted by Stewart-Warner Corporation, in the case at bar, and that such decisions are in conflict and at variance with the decisions of the Court of Appeals for the 4th Circuit so that the requested transfer of the case at bar would be highly prejudicial to your petitioner and would place your petitioner at a serious disadvantage (R. pp. 43-44).

The allegations of the Kalish affidavit and of the Johnson affidavit have not been controverted or answered in any way.

One of the principal questions of fact involved in the action at bar is whether (as respondent contends) respondent's "Alemite" hydraulic couplers are made according to respondent's Butler patent 1,593,791 [9] or whether (as petitioner contends) such "Alemite" hydraulic couplers are substantial copies of petitioner's "Jiffy hydraulic coupler of its Johnson patent 2,040,177 here in suit.

Upon this fact-question the District Court in Illinois [10] and the Court of Appeals for the 7th Circuit [11] have held unfavorably to petitioner's position at bar and favorably to respondent's position at bar.

---

[7] 91 F. 2d 757, supra.

[8] 15 F. Supp. 571; 16 F. Supp. 778; and 31 U.S.P.Q. 195, all supra, and *Alemite Corp.* vs. *Grease-Rite Corp.* Equity No. 9812, not reported.

[9] upon which respondent's chief counsel have placed their principal reliance upon the trial of the aforesaid case of *Jiffy* vs. *Alemite* in North Dakota, which suit was based upon the Johnson patent here in suit.

[10] *Stewart-Warner* vs. *Lincoln,* 15 F. Supp. 571.

[11] *Lincoln* vs. *Stewart-Warner,* 91 F. 2d 757.

On this same fact-question the Courts of the 8th Circuit have twice held favorably to petitioner's position at bar and unfavorably to respondent's position at bar, namely first in *Stewart-Warner* v. *Jiffy* (81 F. 2d 786) and then by the jury and trial judge in the aforesaid case of *Jiffy* v. *Alemite* in North Dakota.

The Court of Appeals for the 8th Circuit, while reversing [12] the jury's fact-finding of invention (concurred in by the trial judge) on the question of *inventiveness*, yet again recognized that the "Alemite" hydraulic coupler is *not* the coupler of respondent's Butler patent 1,593,791, stating:

> ". . . this Court (in *Stewart-Warner v. Jiffy*, 81 F. 2d 786) . . . was of the view that the Alemite hydraulic coupler, made by the Stewart-Warner Corporation, did not conform to the Butler patent . . ." (*Alemite* v. *Jiffy*, 176 F. 2d 444, 447.)

The U. S. Court of Appeals for the 4th Circuit has rendered no decision on this fact-question.

Another question of substantive law involved in the action at bar is whether an infringer who has surreptitiously copied and pirated the patentee's construction prior to the issuance of the patent but while the patentee's application for such patent was pending and with a knowledge of the pendency of such application, may be held liable on account of his use of such construction prior to the issuance of the patent in suit.

Upon this question of substantive law the 4th Circuit has handed down the following decisions favorable to petitioner's position in the action at bar:

Hoeltke v. *C. M. Kemp Mfg. Co.*, 80 F. 2d 912 (C. C. A. 4); certiorari denied 298 U. S. 673;

Chesapeake & Ohio Ry. Co. v. *Kaltenbach*, 124 F. 2d 375 (C. C. A. 4).

---

[12] a petition for writ of certiorari is being filed with respect to this decision; see pages 4-5 supra (see Petition for Re-Hearing R. pp. 78-122).

As pointed out above, the District Court, in the case at bar, entered an Order (R. p. 72) granting Stewart-Warner Corporation's Motion and directing that the case be transferred to the District Court for the Northern District of Illinois, Eastern Division.

From the District Court's opinion (R. pp. 71-72) it will be seen that no consideration whatever was given to your petitioner's uncontroverted showing that the case-law there controlling in the Illinois District and in the 7th Circuit was hostile to petitioner's necessary position in the action at bar.

On August 23, 1949, your petitioner filed its Notice of Appeal (R. p. 73), to the United States Court of Appeals for the Fourth Circuit, from the aforesaid District Court's Order of July 22, 1949.

Proceedings in the Court of Appeals

On or about October 1, 1949, Stewart-Warner Corporation filed a Motion to Dismiss the Appeal upon the ground that the Court of Appeals was without jurisdiction to hear and decide the appeal as being neither an appealable final judgment nor an appealable interlocutory decision and as involving a matter in the discretion of the trial court.

Stewart-Warner Corporation's Motion to Dismiss was argued before the Court of Appeals for the 4th Circuit, on October 7, 1949 and, on October 10, 1949, the Court handed down its decision (R. pp. 123-6) (reported at — F. 2d —, 83 U. S. P. Q. 144), which, *inter alia,* dismissed your petitioner's appeal and held that the District Court's Order of July 29, 1949 was neither a final order from which an appeal lies under Section 1291 of Title 28, United States Code, nor an order granting an interloctuory injunction, from which an appeal lies under Section 1292(1) of Title 28, United States Code, and further holding that, even if the Order of

July 29, 1949 was appealable, the appeal should be dismissed as presenting no question of the substance, there being nothing in the record to indicate that the District Judge abused his discretion in directing removal of the action.

Here again, no consideration was given to your petitioner's uncontroverted showing that the case-law in the Seventh Circuit was hostile to your petitioner's necessary position in the action at bar.

Jurisdiction

This is a suit arising under the Patent Laws of the United States. The District Court's jurisdiction over the subject-matter was invoked under Sections 4919 and 4921 of the Revised Statutes of the United States (35 U. S. C. 67 and 70). The District Court's jurisdiction over defendant, Stewart-Warner Corporation, was invoked under Section 48 of the Judicial Code (28 U. S. C. 109), which provides:

> "In suits brought for the infringement of letters patent the district courts of the United States shall have jurisdiction, in law or in equity, in the district of which the defendant is an inhabitant, . . ."

Since the institution of this action, Section 48 of the Judicial Code has been replaced by Section 1400(b) of Title 28, United States Code (effective September 1, 1948), which provides:

> "Any civil action for patent infringement may be brought in the judicial district where the defendant resides,[13] . . ."

The jurisdiction of this Court is invoked under Section 1254(1) of Title 28, United States Code, or, *in the alternative,* under the Court's general supervisory power to review and correct judgments and orders of the lower Fed-

---

[13] according to the Reviser's Notes: "Words 'inhabitant' and 'resident', as respects venue, are synonymous."

eral Courts by proceedings in the nature of mandamus or certiorari, as implemented by Section 1651 of Title 28 of the United States Code.

Questions Involved

1) Did the 1948 Revision of the Judicial Code (Title 28, United States Code), in providing, in Section 1404(a) for codification of the doctrine of "forum non conveniens" (which permitted dismissal of an action where it could be brought in a more convenient forum, even though the venue was proper), contemplate a departure from the well-established principle that a dismissal of an action under the doctrine of "forum non conveniens" was a final decision appealable under Section 1291 of Title 28, United States Code (as finally and conclusively terminating the action in the jurisdiction chosen by plaintiff, even though plaintiff had the right to litigate the matter in a more convenient forum)?

or, stating it another way,

Is a District Court's Order, made (upon defendant's Motion and over plaintiff's objection) under Section 1404(a) of Title 28, United States Code, transferring an action to another District *in another Circuit*, an order from which an appeal lies under Section 1291 of Title 28, United States Code, as being a final decision in that it effectively ousts and terminates the plaintiff's action in the District and in the Circuit which he has selected, even though plaintiff has the privilege of proceeding against defendant in another District and Circuit of defendant's selection?

2) If a District Court's order, made (upon defendant's Motion and over plaintiff's objection) under Section 1404(a) of Title 28, United States Code, transferring a case to another District *in another Circuit*, is not an appeal-

able final decision, then is it an interlocutory order granting an injunction, which is appealable under Section 1292(1) of Title 28, United States Code, in that it effectively enjoins plaintiff from continuing the prosecution of his suit in the District and Circuit of his choice?

or, stating it another way,

Is not a plaintiff entitled to appellate review in the Court of Appeals of his choice and, therefore, is not any order of the District Court which transfers the action to another District *in another Circuit* an appealable interlocutory order under Section 1292(1) of Title 28, United States Code, as preventing plaintiff from exercising his right of appeal to the Court selected by him?

3) Is not "the interest of justice" more important than "the convenience of parties and witnesses" in determining whether the Court should transfer an action properly instituted in the jurisdiction in which defendant is normally and logically suable, that is in the State and District of which defendant is a citizen, resident and inhabitant; and does it not constitute an abuse of discretion for a District Court (upon defendant's Motion and over plaintiff's objection) to direct transfer of such an action to a different District and Circuit simply upon controverted affidavits alleging "convenience" in the face of *un*controverted affidavits (quoting the movant's attorney's own prior pleadings and Brief) showing that the requested transfer would effect a change in the substantive law applicable to the case, and hence would result in prejudice to plaintiff and would, therefore, *not* be in the "interest of justice"?

or, stating it another way,

Where a plaintiff is properly in court in the jurisdiction which defendant has designated as the one in which he is to be sued (i.e. in the State and District of which defendant

is a citizen, resident and inhabitant) and wherein the Courts have rendered decisions favorable to plaintiff's cause of action, can a District Court (upon the defendant's Motion and over plaintiff's objection) direct the case to be transferred to another District and Circuit in which the Courts have rendered decisions *un*favorable to plaintiff's cause of action, simply upon a controverted showing of "convenience" or does such a transfer constitute an abuse of discretion as *not* being in the "interest of justice"?

Reasons Relied On for Allowance of Writ

1) Section 1404(a) of Title 28, United States Code, as recently enacted, poses important and novel questions of Federal law which were passed upon by the District Court and the Court of Appeals in this case and which have not been, but should be, settled by this Court. The importance of early interpretation of this Section has been recognized by this Court.

Authorities in Support of Reason 1

That an important question of Federal law is involved is a recognized ground for granting certiorari.

Douglas v. *Cunningham,* 294 U. S. 207, 209, 79 L. Ed. 862, 864.

This Court has reviewed a number of lower Federal Court orders entered under recently enacted Section 1404(a) of Title 28, United States Code.

Ex parte Collett, 337 U. S. 55, 93 L. Ed. 901;

Kilpatrick v. *Texas & Pacific Railway Co.,* 337 U. S. 75, 93 L. Ed. 912;

United States v. *National City Lines,* 337 U. S. 78, 93 L. Ed. 914.

2) Whether or not an order (entered upon defendant's motion under Section 1404(a) of Title 28, United States

Code and over plaintiff's objection) directing transfer of a properly instituted action, to another District and Circuit, is a final appealable decision within the meaning of Section 1291 of Title 28, United States Code (i.e. as a decision finally terminating the action in the District and Circuit selected by plaintiff) is an important Federal question which has not heretofore been considered or settled by this Court, and which has been passed upon by the Court of Appeals in this case in a way probably in conflict with the applicable decisions of this Court and of Courts of Appeal for other Circuits (which are to the effect that Section 1404(a) of Title 28, United States Code, is nothing more than a codification of the doctrine of "forum non conveniens", under which dismissal of a complaint is unquestionably an appealable final decision).

Authorities in Support of Reason 2

That an important Federal question is involved and that the decision below is in conflict, or probable conflict, with the applicable decisions of this Court, and of Courts of Appeal for other Circuits are recognized grounds for certiorari.

Douglas v. *Cunningham,* 294 U. S. 207, 209, 79 L. Ed. 862, 864;

Faulkner v. *Gibbs,* 338 U. S. —, 94 L. Ed. 30, 83 USPQ 192;

Jungersen v. *Ostby and Barton Co.,* 335 U. S. 560, 93 L. Ed. 232, 234;

Mandel Bros. v. *Wallace,* 335 U. S. 291, 93 L. Ed. 11, 12.

Section 1404(a) of Title 28, United States Code, is merely a codification of the doctrine of "forum non conveniens".

Reviser's Notes; United States Code, Title 28, Section 1404(a);

Ex parte Collett, 337 U. S. 55, 93 L. Ed. 901, 903;

United States v. *National City Lines,* 337 U. S. 78, 93 L. Ed. 914, 915.

Dismissal of a complaint because of "forum non conveniens" is unquestionably an appealable final decision.

Koster v. *Lumbermen's Mutual Casualty Co.,* 153 F. 2d 888 (CCA 2); affirmed 330 U. S. 501, 91 L. Ed. 1055;

Gilbert v. *Gulf Oil Corp.,* 153 F. 2d 883 (CCA 2); reversed on other grounds 330 U. S. 501, 91 L. Ed. 1055;

Williams v. *Green Bay & Western R. Co.,* 147 F. 2d 777 (CCA 2) reversed on other grounds 326 U. S. 549, 90 L. Ed. 311;

Porta v. *Watts,* 109 F. 2d 966, 969 (CCA 10).

3) Whether or not an order (entered upon defendant's motion under Section 1404(a) of Title 28, United States Code and over plaintiff's objection) directing transfer of a properly instituted action, to another District and Circuit, is an appealable interlocutory order granting an injunction within the meaning of Section 1292(1) of Title 28, United States Code (i. e. as an order enjoining plaintiff from proceeding with the action in the District and Circuit selected by him wherein the Courts have handed down decisions favorable to his view of the case, and, instead, relegating plaintiff to proceeding in another District and Circuit wherein the Courts have handed down decisions *un*favorable to his view of the case) is an important Federal question which has not heretofore been considered or settled by this Court, and which has been passed upon by the Court of Appeals in this case in a way probably in conflict with the applicable decisions of this Court (which are to the effect that an interlocutory order which prevents a litigant from relying on important substantive rights involved in the trial of a pending action is an appealable interlocutory decree granting an injunction).

Authorities in Support of Reason 3

That an important question of Federal law is involved and that the decision below is probably in conflict with applicable decisions of this Court are recognized grounds for granting certiorari.

Douglas v. *Cunningham,* 294 U. S. 207, 209, 79 L. Ed. 862, 864;

Faulkner v. *Gibbs,* 338 U. S. —, 94 L. Ed. 30, 83 U. S. P. Q. 192.

An order which prevents a litigant from relying on important substantive rights involved in the trial of a pending action is appealable under Section 1292(1) of Title 28, United States Code, as an interlocutory decree granting an injunction.

Enelow v. *New York Life Insurance Co.,* 293 U. S. 379, 381, 383, 79 L. Ed. 440, 442-3;

Ettelson v. *Metropolitan life Insurance Co.,* 317 U. S. 188, 191-2, 87 L. Ed. 176, 178-9.

A litigant should not be compelled to proceed with a costly and time-consuming trial where he is entitled to trial in a different manner or in a different Court.

Matter of Simons, 247 U. S. 231, 239-240, 62 L. Ed. 1094, 1096;

Matter of Skinner & Eddy Corp., 265 U. S. 86, 95-96, 68 L. Ed. 912, 915;

Los Angeles Brush Mfg. Corp. v. *James,* 272 U. S. 701, 706, 708, 71 L. Ed. 481, 483, 484.

4) Whether or not a District Judge can, without abusing his discretion, direct transfer of a pending action from the forum of plaintiff's choice to another District and Circuit simply upon affidavits alleging that such a transfer would be for the "convenience of parties and witnesses" and

without any further showing that it would be in the "interest of justice"

> (especially where, as in the case at bar, these affidavits as to "convenience" are inconclusive and are controverted by answering affidavits indicating no particular inconvenience in proceeding in the forum selected by plaintiff and where uncontroverted answering affidavits indicate that such transfer would *not* be in the "interest of justice" because it would require plaintiff to try the action in a District and Circuit in which the law is less favorable to his view of the case)

is an important Federal question which has not heretofore been considered or settled by this Court

> (and as to which decisions have heretofore been rendered by many lower Federal Courts in various Circuits, so that the point should be settled by this Court in the interest of uniformity of decision in the lower Federal Courts)

and which the District Court and the Court of Appeals in the case at bar have decided in a manner probably in conflict with the decisions of this Court and of the Courts of Appeal for other Circuits interpreting the doctrine of "forum non conveniens".

Authorities in Support of Reason 4

That an important Federal question is involved and that the decision below is in conflict, or probable conflict, with the applicable decisions of this Court and of Courts of Appeal for other circuits are recognized grounds for certiorari.

Douglas v. *Cunningham,* 294 U. S. 207, 209, 79 L. Ed. 862, 864;

Faulkner v. *Gibbs,* 338 U. S. —, 94 L. Ed. 30; 83 U. S. P. Q. 192;

Jungersen v. *Ostby and Barton Co.*, 335 U. S. 560, 93 L. Ed. 232, 234;

Mandel Bros. v. *Wallace*, 335 U. S. 291, 93 L. Ed. 11, 12.

In determining whether an action should be transferred to another District *in another Circuit*, under Section 1404(a) of Title 28, United States Code, "interest of justice" is more important than the mere "convenience" of a party.

Gulf Oil Corp. v. *Gilbert*, 330 U. S. 501, 508, 91 L. Ed. 1055, 1062;

Williams v. *Green Bay & Western R. Co.*, 326 U. S. 549, 554, 559-560, 90 L. Ed. 311, 315, 318;

International Milling Co. v. *Columbia Transportation Co.*, 292 U. S. 511, 521, 78 L. Ed. 1396, 1401-2;

Canadian Pacific Ry. Co. v. *Sullivan*, 126 F. 2d 433, 439-40 (C. C. A. 1) certiorari denied 316 U. S. 696, 86 L. Ed. 1766;

Brown v. *Insurograph*, 85 F. Supp. 328, 330-1 (D. C. Del.).

It is in the interest of justice that a patentee be free to sue for infringement in at least two different Circuits of his choice.

Schriber-Schroth Co. v. *Cleveland Trust Co.*, 305 U. S. 47, 50, 83 L. Ed. 34, 36;

Paramount Publix Corp. v. *American Tri-Ergon Corp.*, 294 U. S. 477, 79 L. Ed. 1005; 293 U. S. 587, 79 L. Ed. 682; 293 U. S. 528, 79 L. Ed. 638.

In a number of cases, the lower Federal Courts have refused to transfer a pending action to another District in another Circuit, in the absence of any conclusive showing that it would be in the interest of justice, especially where the "convenience" to defendant is not particularly great or is doubtful.

Auburn Capitol Theatre Corp. v. *Schine Chain Theatres*, 83 F. Supp. 872 (D. C. S. D. N. Y.);

Perry v. *Atchison T. & S. F. Ry. Co.*, 82 F. Supp. 912, 913 (D. C. N. D. Cal.);

Bolton v. *General Motors Corp.*, 81 F. Supp. 851, 852 (D. C. N. D. Ill.);

Levenson v. *Little*, 81 F. Supp. 513, 517 (D. C. S. D. N. Y.);

Brown v. *Insurograph*, 85 F. Supp. 328, 330-1 (D. C. Del.).

The Court of Appeals for the 4th Circuit has heretofore rendered decisions favorable to your petitioner's case, in the action at bar.

Hoeltke v. *C. M. Kemp Mfg. Co.*, 80 F. 2d 912 (C. C. A. 4); certiorari denied 298 U. S. 673;

Chesapeake & Ohio Ry. Co. v. *Kaltenbach*, 124 F. 2d 375 (C. C. A. 4).

The Courts of the 7th Circuit, and particularly the District Court for the Northern District of Illinois, have heretofore rendered decisions with respect to Stewart-Warner Corporation's "Alemite" hydraulic couplers, which are unfavorable to your petitioner's case, in the action at bar.

Stewart-Warner Corp. v. *LeVally*, 15 F. Supp. 571 and 16 F. Supp. 778 and 31 U. S. P. Q. 195 (D. C. N. D. Ill.);

Alemite Corp. v. *Grease-Rite Corp.* (D C. N. D. Ill. Eq. 9812) not reported;

Lincoln Engineering Co. v. *Stewart-Warner Corp.*, 91 F. 2d 757 (C. C. A. 7); reversed at 303 U. S. 545, 82 L. Ed. 1008;

The aforesaid decisions of the Court of the 7th Circuit are in conflict with the applicable decisions of this Court in the following cases:

Lincoln Engineering Company of Illinois v. *Stewart-Warner Corporation*, 303 U. S. 545, 82 L. Ed. 1008;

Bassick Manufacturing Company v. *R. M. Hollingshead Company*, 298 U. S. 415, 80 L. Ed. 1251;
Rogers v. *Alemite Corporation*, 298 U. S. 415, 80 L. Ed. 1251.

5) In view of the importance of foregoing Reason 4 this Court should review the District Court's order of July 29, 1949 (whereby the District Court in effect decided that it would proceed no further with the case thereby barring plaintiff from recourse to the Court of Appeals for the Fourth Circuit as well) by way of writ of mandamus or certiorari, under its power of supervision of the lower Federal Courts even if it decides that the aforesaid order of July 29, 1949 was not appealable to the Court of Appeals for the Fourth Circuit, under either Section 1291 or Section 1292(1) of Title 28, United States Code.

Authorities in Support of Reason 5

This Court has, on motions for leave to file petitions for writ of mandamus or certiorari, reviewed orders of District Courts entered under Section 1404(a) of Title 28, United States Code.

Ex parte Collett, 337 U. S. 55, 93 L. Ed. 901;
Kilpatrick v. *Texas & Pacific Railway Co.*, 337 U. S. 75, 93 L. Ed. 912;
United States v. *National City Lines*, 337 U. S. 78, 93 L. Ed. 914.

This Court has granted relief, by way of writ of mandamus, against orders which would require a litigant to proceed with a costly and time-consuming trial where he is entitled to a trial in a different manner or in a different Court.

McClellan v. *Carland*, 217 U. S. 268, 280, 54 L. Ed. 762, 766;

Matter of Simons, 247 U. S. 231, 239-240, 62 L. Ed. 1094, 1096;
Ex parte United States, 287 U. S. 241, 246, 77 L. Ed. 283, 285;
Matter of Skinner & Eddy Corp., 265 U. S. 86, 95-96, 68 L. Ed. 912, 915;
Los Angeles Brush Mfg. Corp. v. *James,* 272 U. S. 701, 706, 708, 71 L. Ed. 481, 483, 484.

Conclusion

WHEREFORE, your petitioner respectfully prays for a writ of certiorari to the United States Court of Appeals for the Fourth Circuit, to the end that this cause may be reviewed and determined by this Court, and that the judgment and decision of the Court of Appeals for the Fourth Circuit dismissing your petitioner's appeal may be reversed

or, in the alternative,

that your petitioner be granted leave to file a petition for a writ of mandamus or certiorari and that such writ be issued to the United States District Court for the Eastern District of Virginia, to the end that this cause may be reviewed and determined by this Court, and that the Order of the District Court dated July 29, 1949, directing transfer of this action to the District Court for the Northern District of Illinois, Eastern Division, be vacated and set aside, and that your petitioner may be granted such other and further relief as may to this Court seem proper.

JIFFY LUBRICATOR COMPANY, INC.,
By LEONARD L. KALISH,
WILLIAMS, MULLEN & HAZELGROVE,
LITTLETON M. WICKHAM,
Attorneys for Petitioner.

Counsel's Certificate

The undersigned hereby certify that the foregoing petition is, in their opinion, well founded, and that the case is one in which the petitioner's prayer should be granted by this Court.

LEONARD L. KALISH,
GUY B. HAZELGROVE,
LITTLETON M. WICKHAM for
WILLIAMS, MULLEN & HAZELGROVE,
Attorneys for Petitioner.

(5352)

FILE COPY

FILED
DEC 24 1949
CHARLES ELMORE CROPLEY
CLERK

Supreme Court of the United States

No. 460 October Term, 1949

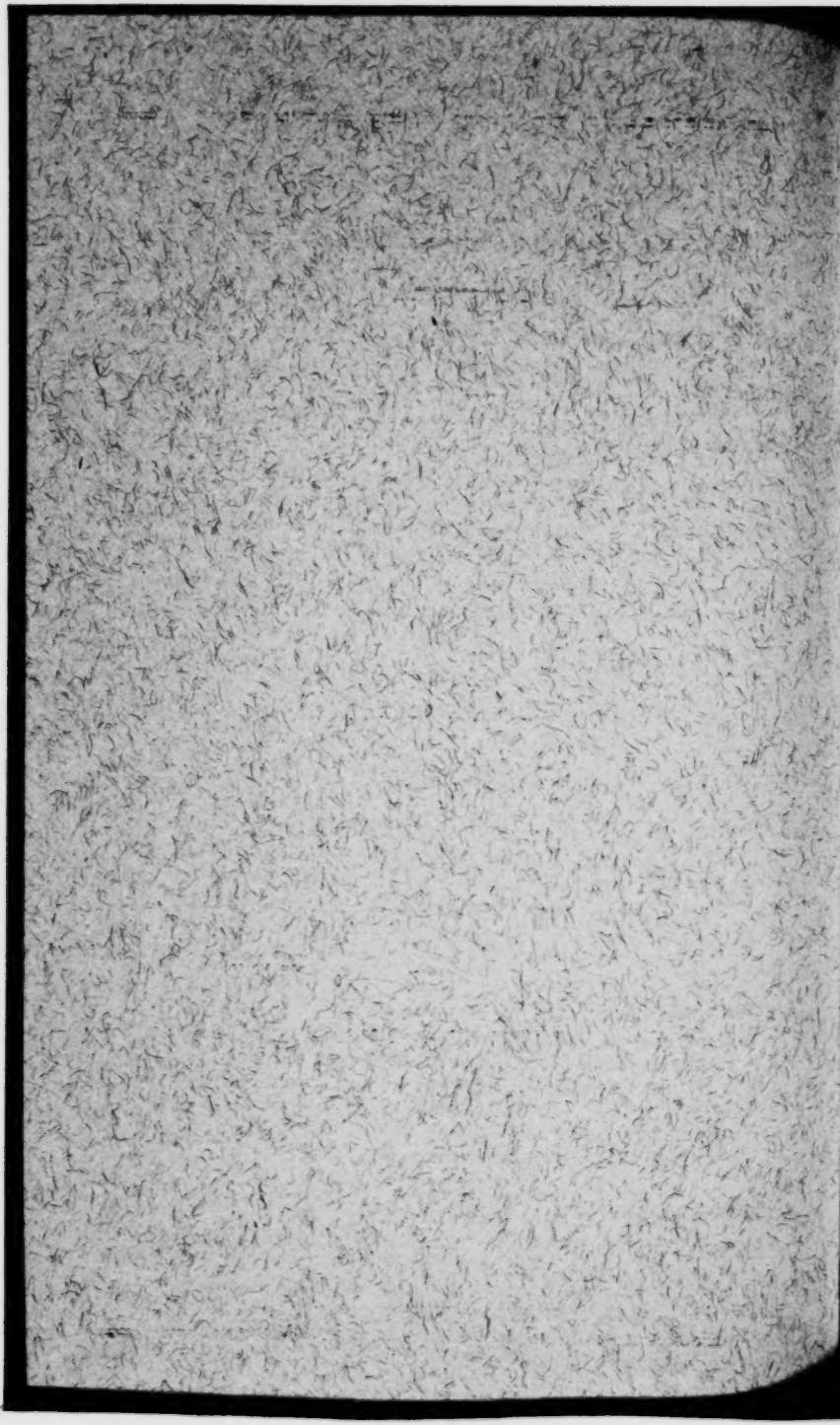
Jiffy Lubricator Company, Inc.,
plaintiff-petitioner,

v.

Stewart-Warner Corporation,
defendant-respondent

Brief in Support of Petition for Writ of Certiorari and in support of the alternative Motion for Leave to File Petition for Writ of Mandamus or Certiorari

Leonard L. Kalish,
Littleton M. Wickham,
Guy B. Hazelgrove,
Williams, Mullen & Hazelgrove,
Attorneys for Petitioner.



Index to Subject Matter

	PAGES
Opinions of the Courts below	1
Jurisdiction	1–2
Statement of the Case	2–4
respondent's unwarranted suit against petitioner in 1931 on account of petitioner's manufacture and sale of the hydraulic coupler here in suit, and respondent's piracy of petitioner's hydraulic coupler of the patent here in suit	3–4
Petitioner's infringement-suit in 8th Circuit against respondent's imitative hydraulic coupler here in suit	5–6
Questions Involved	6
Reasons relied on for allowance of writ	6

ARGUMENT

Argument, Point 1:	
Case at bar poses important and novel questions of Federal law under 28 U.S.C. 1404(a), which have not heretofore been considered by this Court, and an early determination of which, by this Court, is important to the general administration of the Federal Courts	7–8
Argument, Point 2:	
Order directing transfer (to another District and Circuit) under 28 U.S.C. 1404(a), is appealable under 28 U.S.C. 1291 as a *final* order, and 4th Circuit's contrary conclusion in case at bar is probably in conflict with the applicable analogous decisions of this Court and of the Courts of Appeal of other Circuits	8–14
Argument, Point 3:	
Order directing transfer (to another District and Circuit) under 28 U.S.C. 1404(a), is appealable under 28 U.S.C. 1292(1) as an interlocutory order granting an injunction, and 4th Circuit's contrary conclusion is probably in conflict with the applicable analogous decisions of this Court	15–22

PAGES

Argument, Point 4:

To justify transfer under 28 U.S.C. 1404(a), "interest of justice" must be shown in addition to "convenience". 23

Argument, Point 4-a:

Where patent-infringement is instituted in District of *defendant's domicile*, it may not be transferred to another District and Circuit (over plaintiff's opposition) merely upon defendant's affidavits showing that its principal place of business and records are in such other District and Circuit, in face of the showing in plaintiff's opposing affidavit that no unusual inconvenience would be imposed on defendant to try case in the District of defendant's domicile where suit was properly instituted and maintainable, and the 4th Circuit's contrary conclusion is probably in conflict with the applicable analogous decisions of this Court and of the Courts of Appeal and District Courts of other Circuits..... 24–33

Argument, Point 4-b:

Where plaintiff's opposing affidavits show, *without controversion*, that the applicable decisional-law bearing upon the controversy is *less* favorable to plaintiff (and *more* favorable to defendant) in the District to which defendant seeks to transfer, than in the District where suit was properly instituted and maintainable, it is not "in the interest of justice" to grant defendant's motion under 28 U.S.C. 1404(a), and such transfer is an abuse of judicial discretion, and the contrary conclusion of the 4th Circuit is probably in conflict with the applicable analogous decisions of this Court and of the Courts of Appeal and the District Court of other Circuits..... 34–40

Argument, Point 5:

In view of the importance of the questions involved, this Court should review District Court's Order (of transfer) by way of writ of mandamus or *certiorari* to the District Court, if this Court deems such Order not appealable either under 28 U.S.C. 1291 or under 28 U.S.C. 1292(1)..... 41–45

Conclusion..... 45–46

Table of Cases

PAGES

Alemite Corp. *v.* Lubrair Corp., 62 F.2d 899; (CCA-1)..... 5

Auburn Capitol Theatre Corp. *v.* Schine Chain Theatres, 83 F.Supp. 872 (DC SD NY)..... 40

Bassick Mfg. Co. *v.* R. M. Hollingshead Co., 298 U.S. 415..2, 5, 6, 38

Bolten *v.* General Motors Corp., 81 F.Supp. 851, 852 (DC ND Ill).....39, 40

Brown *v.* Insurograph 85 F. Supp. 328, 330, 331 (DC Del)....26, 40

Canadian Pacific Ry. Co. *v.* Sullivan, 126 F.2d 443, 439-440 (CCA-1)..... 31

Chesapeake & Ohio Ry. Co. *v.* Kaltenbach, 124 F.2d 375, 376-7 (CCA-4)..... 36

E parte Collett, 337 U.S. 55.....7, 8, 10, 41

Cresta Blanca Wine Co. *v.* Eastern Wine Corp., 143 F.2d 1012, 1014-5 (CCA-2)..... 20

Crosley Corp. *v.* Hazeltine Corp., 122 F.2d 925, 927 (CCA-3). 20

Crosley Corp. *v.* Westinghouse Electric & Mfg. Co., 130 F.2d 474, 475 (CCA-3), certiorari denied 317 U.S. 681 (87 L.Ed 546)..... 20

Douglas *v.* Cunningham, 294 U.S. 207, 209.....7, 9, 16, 24

Enelow *v.* New York Life Insurance Co., 292 U.S. 379, 381, 383.....17, 19, 22

Ettelson *v.* Metropolitan Life Insurance Co., 317 U. S. 188, 191-2.....14, 18, 19, 21, 22

Faulkner *v.* Gibbs, 338 U.S. (94 L.Ed 30).....9, 16, 24

In re Forstner Chain Corp., F.2d, 83 USPQ (CA-1, decided November 10, 1949)..... 13

Gilbert *v.* Gulf Oil Corp., 153 F.2d 883, 884 (CCA-2); reversed on other grounds, 330 U.S. 501..... 11

Gulf Oil Corp. *v.* Gilbert, 330 U.S. 501, 508..... 29

Hoeltke *v.* C. M. Kemp Mfg. Co., 80 F.2d 912, 913 (CCA-4), certiorari denied, 298 U.S. 673..... 35

International Milling Co. *v.* Columbia Transportation Co., 292 U.S. 511, 521..... 31

Jungersen *v.* Ostby and Barton Co., 335 U.S. 560.....9, 24, 34

Kilpatrick *v.* Texas & Pacific Railway Co., 337 U.S. 705..... 7, 41

PAGES

Koster *v.* Lumbermen's Mutual Casualty Co., 153 F.2d 888, 889 (CCA-2), affirmed, 330 U.S. 518 11

Levenson *v.* Little, 81 F. Supp. 513, 517 (DC SD NY) 40

Lincoln *v.* Stewart-Warner, 91 F.2d 757 (CCA-7) 4, 37

Lincoln *v.* Stewart-Warner, 303 U.S. 545 ..... 4, 6, 38

Los Angeles Brush Mfg. Corp. *v.* James, 272 U.S. 701, 701, 706, 708 ..... 22, 43

Mandel Bros. *v.* Wallace, 335 U.S. 291 ..... 9, 24, 34

McClellan *v.* Carland, 217 U.S. 268, 280 41

City of Morgantown *v.* Royal Insurance Co., 337 U.S. 254 19

Paramount Publix Corp. *v.* American Tri-Ergon Corp., 294 U.S. 477 and 293 U.S. 578 and 293 U.S. 528 34

Perry *v.* Atchison T. & S. F. Ry. Co., 82 F.Supp. 912, 913 (DC ND Cal.) 40

Porta *v.* Watts, 109 F.2d 966, 969 (CCA-10) 11

Rogers *v.* Alemite Corp., 298 U.S. 415 ..... 2, 5, 6, 38

Schoen *v.* Mountain Producers Corp., 170 F.2d 707, 715 (CA-3) 29

Schriber-Schroth Co. *v.* Cleveland Trust Co., 305 U.S. 47, 50 .. 34

Matter of Simons, 247 U.S. 231, 239-240 ..... 22, 42

Matter of Skinner & Eddy Corp., 265 U.S. 86, 95-6 ..... 22, 43

Stewart-Warner Corp. *v.* Jiffy Lubricator Co., Inc., 81 F.2d 786 (CCA-8) 3, 4, 37

Stewart-Warner Corp. *v.* LeVally, 15 F. Supp. 571 and 16 F. Supp. 778 and 31 U.S.P.Q. 195 (DC ND Ill) 37

Tivoli Realty *v.* Interstate Circuit, 167 F.2d 155, 157 (CCA-5), certiorari denied 334 U.S. 837 ..... 21, 32

Triangle Conduit & Cable Co. *v.* National Electric Products Corp., 125 F.2d 1008, 1009 (CCA-3), certiorari denied, 316 U.S. 676 (86 L.Ed 1750) 20

Ex parte United States, 287 U.S. 241, 246 43

United States *v.* National City Lines, 337 U.S. 78 ..... 8, 10, 41

Williams *v.* Green Bay & Western R. Co., 326 U.S. 549, 554, 559, 560 30

Williams *v.* Green Bay & Western R. Co., 147 F.2d 777 (reversed on other grounds, 326 U.S. 549) 11

Other Authorities

PAGES

Reviser's Notes on 28 U.S.C. 1404(a)..... 10

Statutes

Section 77-B of the Bankruptcy Act (11 USC 207)..... 11

Section 118, Chapter 10, of the Chandler Act (11 USC 518)... 11

Section 48 of the Judicial Code (28 U.S.C. 109)..... 2

Section 129 of the Judicial Code (28 U.S.C. 227).....18, 20

Section 274-b of the Judicial Code (28 U.S.C. 398)..... 17

Section 1254 of Title 28 of the United States Code..... 2

Section 1291 of Title 28, United States Code.....8, 9, 20, 21, 46

Section 1292(l) of Title 28, United States Code...2, 15, 16, 17, 21, 46

Section 1400(b) of Title 28, United States Code..... 2

Section 1404(a) of Title 28, United States Code....6, 7, 8, 10, 11, 14, 15, 16, 23, 24, 25, 26, 28, 29, 39, 40, 45

Section 1651 of Title 28 of the United States Code..... 2

Section 4919 of the Revised Statutes of the United States (35 U.S.C. 67)..... 1

Section 4921 of the Revised Statutes of the United States (35 U.S.C. 70)..... 1

Brief in Support of Petition for Writ of Certiorari and the alternative Motion for Leave to File Petition for Writ of Mandamus or Certiorari

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

The opinions of the Courts below

The opinion and order of the United States District Court for the Eastern District of Virginia (granting defendant's motion to transfer this cause to the United States District Court for the Northern District of Illinois, Eastern Division) is reproduced in the Transcript of Record (R.p. 72).

The opinion of the United States Court of Appeals for the Fourth Circuit dismissing petitioner's appeal is reproduced in the Transcript of Record (R.pp. 123-126) and is reported at 177 F.2d 360 (83 USPQ 144).

Jurisdiction

The date of the judgment of the United States Court of Appeals for the 4th Circuit (the review of which is sought by writ of certiorari) is October 10, 1949.

The date of the order of the United States District Court for the Eastern District of Virginia (the review of which is sought, in the alternative, by writ of mandamus or certiorari) is July 29, 1949.

The District Court's aforesaid order dated July 29, 1949 was entered in a patent infringement suit arising under the Patent Laws of the United States.

The District Court's jurisdiction over the subject matter was invoked under Sections 4919 and 4921 of the Revised Statutes of the United States (35 U.S.C. 67 & 70).

The District Court's jurisdiction over defendant-respondent, Stewart-Warner Corporation

(a Virginia corporation and admittedly a resident and inhabitant of the Eastern District of Virginia with its statutory office and statutory agent located in Richmond, within the Eastern District of Virginia)

was invoked under Section 48 of the Judicial Code (28 U.S.C. 109), since replaced by Section 1400(b) of Title 28, United States Code (effective September 1, 1948).

The jurisdiction of this Court is invoked under Section 1254 of Title 28, United States Code, or, *in the alternative,* under this Court's general supervisory power to review and correct judgments and orders of the lower Federal Courts by proceeding in the nature of mandamus or certiorari, as implemented by Section 1651 of Title 28, United States Code.

Statement of the Case

The following is supplemental to the brief summary of the facts of the case as set forth at pages 2 to 10, inclusive, of the Petition herein (which summary is included in this Brief, by reference).

Defendant-respondent, Stewart-Warner Corporation is, and for many years has been, by far the largest manufacturer of apparatus for lubrication of automobiles and the like, including so-called "couplers" for effecting a detachable fluid-tight connection between a grease-cup or so-called "nipple" or "fitting" and a lubricant-dispensing grease-gun (R.pp.2-4).

Stewart-Warner Corporation and various subsidiary and affiliated corporations controlled by it have instituted hundreds of unwarranted patent-infringement suits, throughout the United States, against their smaller competitors, based on its Gullborg patent 1,307,734. This Court's opinion in *Bassick Mfg. Co.** v. *R. M. Hollingshead Co.* and *Rogers* v. *Alemite Corp.,** 298 U.S. 415, 416

* Bassick Mfg. Co. and Alemite Corp. were one and the same corporation, merely with a change of name, and such corporation was, at all times herein concerned, a wholly-owned subsidiary of defendant-respondent Stewart-Warner Corporation

(80 L. Ed. 1251, 1252), lists reported decisions in 13 of such actions, which represent a bare handful of the total, most of which are unreported in the Official Reports.

On May 12, 1936, United States Letters Patent No. 2,040,177 were granted to August Johnson and John S. Johnson as assignors to petitioner (R.pp. 16-20), covering an improved hydraulic coupler, which will be referred to hereinafter as the Jiffy coupler (the application for said Letters Patent having been filed on October 30, 1930).

Respondent's unwarranted suit against petitioner in 1931 and its piracy of petitioner's hydraulic coupler of the patent in suit

Plaintiff began marketing its Johnson-invented "Jiffy" hydraulic coupler in 1930 (R.p. 3).

Between June of 1930 and August of 1931, Alemite Corp. obtained a specimen of petitioner's Jiffy hydraulic coupler, through respondent's Fargo, N. D. "distributor", The Alemite Company, and, also through the aforesaid "distributor" learned of the fact that a patent had been applied for on said Johnson-invented Jiffy hydraulic coupler, within a month of the actual filing date of the patent-application (R.pp. 4-5).

Shortly thereafter, respondent charged petitioner with infringement of respondent's aforesaid Gullborg patent 1,307,734, and on August 21, 1931 respondent instituted an infringement suit* against petitioner charging that the lubricating apparatus put out by petitioner constituted an infringement of the aforesaid Gullborg patent 1,307,734. In its answer, filed October 10, 1931, petitioner at bar denied infringement and informed respondent at bar that its Jiffy hydraulic coupler so charged to infringe said Gullborg patent, was the subject of petitioner's then pend-

* this suit being the case of *Stewart-Warner Corp.* v. *Jiffy Lubricator Company, Inc.* (the opinion of the Circuit Court of Appeals for the Eighth Circuit being reported at 81 F. 2d 786)

ing Johnson patent-application, with claims allowed therein (R.p. 5).

By way of supplemental complaint, respondent at bar also charged that petitioner's apparatus constituted an infringement of respondent's Butler patent 1,593,791*.

Having obtained a sample of petitioner's Jiffy coupler in 1930, and having effectively blocked petitioner's sale of its Jiffy hydraulic coupler and of its grease-gun dependent thereon, by tying up petitioner in protracted, expensive, debilitating and sales-depressant patent-litigation upon an unwarranted charge of infringement of respondent's long dormant and unused Butler patent No. 1,593,791, respondent, through its wholly-owned subsidiary, Alemite Corporation, copied petitioner's Jiffy hydraulic coupler and, in June of 1933, began marketing such imitative coupler as its "Alemite hydraulic coupler" (R.pp. 5-6).

In the 1931 suit, the District Court held that petitioner's "Jiffy" hydraulic coupler did not infringe respondent's Butler patent and, on appeal, this was affirmed in *Stewart-Warner Corporation* v. *Jiffy Lubricator Co.*, 81 F.2d 786, wherein the Court of Appeals for the 8th Circuit held that petitioner's Jiffy hydraulic coupler did not come within the scope of the coupler-defining portion of the claim-language of respondent's Butler patent 1,593,791, and further held that respondent's "Alemite" hydraulic coupler (which is here charged to infringe petitioner's Johnson patent 2,040,177) and likewise was not according to its Butler patent and that respondent's "Alemite" hydraulic coupler and petitioner's Jiffy hydraulic coupler were mechanical equivalents (81 F.2d 793) and that respondent's "Alemite" hydraulic coupler was inspired by petitioner's earlier-marketed "Jiffy" hydraulic coupler.

---

* valid but *not* infringed in *Stewart-Warner* v. *Jiffy*, 81 F.2d 786 (CCA 8), and held valid *and* infringed (on identical facts) in *Lincoln* v. *Stewart-Warner*, 91 F.2d 757 (CCA 7), and held invalid on another ground in *Lincoln* v. *Stewart-Warner*, 303 U.S. 545, without disturbing the patentability of the Butler coupler *per se* and without resolving the conflict between the 8th and 7th Circuits as to the scope of the coupler-defining portion of Butler's claim-language

Petitioner's infringement-suit in the 8th Circuit against respondent's imitative hydraulic coupler here involved

After the issuance to petitioner of the patent here in suit, upon Johnson's hydraulic coupler theretofore[1] marketed by petitioner under its trademark "Jiffy", petitioner instituted suit in the U. S. District Court for the District of North Dakota, against respondent's North Dakota distributor, The Alemite Company, on account of the infringement of petitioner's Johnson patent 2,040,177 here in suit by the sale of respondent's aforesaid imitative hydraulic couplers;—said suit being hereinafter referred to as "*Jiffy* v. *Alemite*".

In *Jiffy* v. *Alemite* the trial judge first denied the defendant's motion for a directed verdict, and the jury, after being most adequately and thoroughly instructed (R.pp. 29-39), returned a verdict of $11,371.80 in favor of petitioner, and the trial judge thereafter denied the defendant's timely motion for judgment n.o.v. and also thereafter denied defendant's subsequent and timely motion for a new trial, and on such occasion rendered an opinion expressly concurring in the jury's finding of invention (R.p. 26), and thereafter the trial judge entered judgment in favor of petitioner for the amount of the jury's verdict plus $12,000 for cost and 468.73 for interest.

Upon the appeal of The Alemite Company, in the case of *Jiffy* v. *Alemite*, the U. S. Court of Appeals for the 8th Circuit reversed (176 F. 2d 444) the aforesaid judgment and held petitioner's Johnson patent 2,040,177 invalid on the sole ground that Johnson's (admittedly unanticipated) contribution to the art of lubrication did not rise to the level of patentable invention in view of respondent's Gullborg patent 1,307,734[2] which was *not* relied upon by defendant in *Jiffy* v. *Alemite*, and upon the 8th Circuit's misunderstanding of and conflict with

[1] during the pendency of Johnson's patent-application upon which the patent herein suit was issued

[2] adjudicated in *Bassick* v. *Hollingshead* and *Rogers* v. *Alemite* (298 U.S. 415) and in *Alemite* v. *Lubrair* (62 F.2d 899; CCA-1)

this Court's decisions in *Bassick* v. *Hollingshead* and *Rogers* v. *Alemite* (298 U.S. 415) and in *Lincoln* v. *Stewart-Warner* (303 U.S. 545).

Within the time-extension granted therefor, petitioner filed a timely petition for re-hearing in the U. S. Court of Appeals for the 8th Circuit, in *Jiffy* v. *Alemite,* which petition for re-hearing is reproduced on pages 78 to 121, inclusive, of the printed *Transcript of Record* in the case at bar. The aforesaid petition for re-hearing was denied on October 31, 1949 (without opinion).

On November 25, 1949, a certified Transcript of the Record in the aforesaid case of *Jiffy* v. *Alemite* (176 F. 2d 144), together with 9 uncertified copies thereof, as required by Rule 38 of this Court, were filed in the office of the Clerk of this Court, preparatory to the filing of a petition for writ of certiorari in that case.

A petition, to this Court, for writ of certiorari in respect to the aforesaid decision of the 8th Circuit, is now in preparation and will be filed within time and within about two weeks after the filing of the within brief.

Questions Involved

The *Questions Involved* are set out at pages 11-13 of the Petition and are incorporated herein by reference.

It is submitted that these *Questions* go to matters of trial and appellate procedure in the lower Federal courts which, as will be brought out more fully hereinbelow, are of general importance (over and above their importance to the litigants at bar) and are novel questions of law bearing on the interpretation of recently-enacted Section 1404(a) of Title 28, United States Code, and that, therefore, the present Petition is one which should be granted by this Court.

Reasons Relied on for Allowance of Writ

The reasons relied on for the allowance of the Petition are set out on pages 13-21 of the Petition and are incorporated herein by reference.

These Reasons and the authorities relied on in support thereof, are discussed hereinbelow in the Argument;—the Argument points being numbered to correspond to the Reasons relied on.

ARGUMENT

Argument—Point 1

Case at bar poses important and novel questions of Federal law under 28 U.S.C. 1404(a), which were passed upon by the District Court and the Court of Appeals in this case and which have not been, but should be, settled by this Court. The importance of early interpretation of this Section has been recognized by this Court.

This case involves the interpretation of Section 1404(a) of Title 28, United States Code, as recently enacted (effective September 1, 1948) which reads as follows:

> "For the convenience of parties and witnesses, in the interest of justice, the District Court may transfer any civil action to any other District or Division where it might have been brought."

The interpretation of this recently-enacted statute poses important and novel questions of Federal law going to the nature and extent of a District Judge's power to transfer, to another District in another Circuit, a properly instituted action pending before him, and going also to the appealability of a District Court's order directing such transfer.

That an important question of Federal law is involved is, of course, a recognized ground for granting certiorari. *Douglas* v. *Cunningham,* 294 U.S. 207, 209 (79 L. Ed. 862, 864).

This Court has recognized the importance of an early interpretation of Section 1404(a) of Title 28, United States Code, by reviewing a number of lower Federal Court orders entered under this recently-enacted statute. See *Ex parte Collett,* 337 U.S. 55 (93 L. Ed. 901); *Kilpatrick* v. *Texas & Pacific Railway Co.,* 337 U.S. 705

(93 L. Ed. 912); *United States* v. *National City Lines*, 337 U.S. 78 (93 L. Ed. 914).

In the *Ex parte Collett* case, supra, this Court made the following pertinent statement:

> "Since that issue* seemed of importance in the determination of justice, we assigned the case for hearing on the motion."

The questions presented by the present Petition are different from those presented in the three above-cited cases (which involved the consideration of the applicability of Section 1404(a) to suits brought under specific Acts) and, so far as we are aware, the questions involved in the present Petition have never heretofore been presented to this Court for its consideration.

Argument—Point 2

Whether or not an order (entered upon defendant's motion under 28 U.S.C. 1404-a and over plaintiff's objection) directing transfer of an action *properly instituted (and maintainable) in the District of defendant's domicile*, to another District and Circuit, is a final appealable decision within the meaning of 28 U.S.C. 1291,

> **(i.e. as a decision finally terminating the action in the District and Circuit selected by plaintiff)**

is an important Federal question which has not heretofore been considered or settled by this Court and which has been passed upon by the Court of Appeals in this case in a way probably in conflict with the applicable analogous decisions of this Court and of the Courts of Appeal for other Circuits

> **(which are to the effect that 28 U.S.C. 1404-a is nothing more than a codification of the doctrine of "forum non conveniens", under which dismissal of a complaint is unquestionably an appealable final decision).**

It is petitioner's contention that the District Court's Order (R.p. 72) dated July 29, 1949

> (which, over petitioner's objection, granted defendant-respondent's motion under Section 1404-a of Title

*namely, whether the District Court had exceeded its authority or abused its discretion, in transferring the case to another District in another Circuit

28, United States Code and directed transfer of this action to the United States District Court for the Northern District of Illinois, Eastern Division)

was a final decision which was appealable to the U. S. Court of Appeals for the 4th Circuit, within the meaning of Section 1291 of Title 28, United States Code, which provides, inter alia:

> "The courts of appeals shall have jurisdiction of appeals from all final decisions of the district courts of the United States, . . ."

The decision (R.pp. 123-126; reported at 177 F. 2d 360, 83 USPQ 144) and judgment (R.p. 126) of the Court of Appeals (the review of which is sought by the present petition) held, on the contrary, that the aforesaid order of July 29, 1949 was *not* such a final appealable decision.

It is submitted that this question (which, so far as we are aware, has not heretofore been considered or settled by this Court) is one which merits review by this Court

as constituting an important question of Federal law[1], and

as being in probable conflict[2] with the applicable decisions of this Court (to be discussed hereinbelow) interpreting the principle of "forum non conveniens", and

as being in conflict[3] with the decisions (to be discused hereinbelow) of the Courts of Appeals for other Circuits on what constitutes an appealable final decision.

---

[1] petitioner relies on *Douglas* v. *Cunningham*, 294 U.S. 207, 209 (79 L. Ed. 862, 864), as authority for the granting of certiorari where the question involved is an important question of Federal law

[2] petitioner relies on *Faulkner* v. *Gibbs*, 338 U.S. (94 L. Ed. 30), as authority for the granting of certiorari where the decision below is in probable conflict with applicable decisions of this Court

[3] petitioner relies on *Jungersen* v. *Ostby and Barton Co.*, 335 U.S. 560 (93 L. Ed. 232, 234), and *Mandel Bros.* v. *Wallace*, 335 U.S. 291 (93 L. Ed. 11, 12), as authority for the granting of certiorari where the Court of Appeals' decision below is in conflict with the decisions of Courts of Appeals for other Circuits

Section 1404(a) of Title 28, United States Code, as enacted effective September 1, 1948, had no counterpart in the Judicial Code or any other antecedent Federal statutes.

The reason for the enactment of Section 1404(a) is set forth in the Reviser's Notes in the following language:

> "Subsection (a) was drafted in accordance with the doctrine of forum non conveniens permitting transfer to a more convenient forum, even though the venue is proper . . . The new subsection requires the courts to determine that the transfer is necessary for the convenience of parties and witnesses, and further, that it is in the interest of justice to do so."

The Reviser's language was adopted by this Court in *Ex parte Collett* 337 U.S. 55, 93 L. Ed. 901, 903, supra (see 93 L. Ed. 903), while in *United States* v. *National City Lines,* supra, this Court, in referring to the aforesaid Reviser's Notes on Section 1404(a) stated:

> "The reviser's notes are so obviously authoritative in perceiving the meaning of the Code that the government itself in discussing a section other than §1404(a) refers to them in its brief in this case. And we have already had occasion to look to the reviser's notes" (337 U.S. ; 93 L. Ed. 916).

It is clear, therefore, that Section 1404(a) of Title 28, United States Code, is primarily a codification of the long-established decisional-law or principle of *"forum non conveniens"* under which a Federal District Court has, for many years, had the power to dismiss an action properly instituted and pending before it, if it found that the forum was inconvenient and that another and more convenient forum existed in which plaintiff could institute his suit against the same defendant.

Under this principle of "forum non conveniens" as it existed prior to the effective date of Section 1404(a) of Title 28, United States Code, it was settled, beyond any question of doubt, that a District Court's order dismissing a complaint was a final appealable decision since it effectively terminated the action in the District Court selected

by plaintiff, even though plaintiff had the right to litigate the same issues against the same defendant in another District Court. As illustrative of appeals taken from District Court orders dismissing complaint on the principle of "forum non conveniens", see *Koster* v. *Lumbermen's Mutual Casualty Co.* 153 F. 2d 888, 889 (CCA 2); affirmed 330 U.S. 518 (91 L. Ed 1067); *Gilbert* v. *Gulf Oil Corp.* 153 F. 2d 883, 884 (CCA 2); reversed on other grounds 330 U.S. 501, 91 L. Ed. 1055; *Williams* v. *Green Bay & Western R. Co.* 147 F. 2d 777; reversed on other grounds 326 U.S. 549 (90 L. Ed. 311).

See also *Porta* v. *Watts* 109 F. 2d 966, 969 (CCA 10) which was a petition for reorganization under Section 77-B of the Bankruptcy Act (11 USC 207) wherein the Court entertained an appeal from the District Court's denial of an application to transfer the proceeding to another District in accordance with Section 118, Chapter 10, of the Chandler Act (11 USC 518) which provides:

> "The judge may transfer a proceeding under this chapter to a court of bankruptcy in any other district, regardless of the location of the principal assets of the debtor or its principal place of business, if the interests of the parties will be best served by such transfer."

Clearly, the above-quoted section is analogous to Section 1404(a) of Title 28, U. S. Code, so far as concerns the appealability of the order granting or denying an application for transfer to another District and, accordingly, the decision of the Court of Appeals in the case at bar is respectfully submitted to be in conflict with the decision of the Court of Appeals for the 10th Circuit in *Porta* v. *Watts,* supra.

In dismissing petitioner's appeal, the Court of Appeals for the 4th Circuit held (in the case at bar) that, before a decision could be appealable, it:

> "must be not only final but complete, that is, final not only as to all parties, but as to the whole subject-matter and as to all causes of action involved; and that if the judgment or decree be not thus final and

complete, the writ of error or appeal must be dismissed for want of jurisdiction." (R.p. 124; 177 F. 2d 361-2; 83 USPQ 145.)

In other words, the Court of Appeals for the 4th Circuit based its decision, dismissing petitioner's appeal, upon the conclusion that an order is not appealable if it still leaves something to be adjudicated such as might thereafter require review by way of further appeal.

It is submitted that the above-quoted statement was not properly applicable to the facts at bar and that, therefore, the Court of Appeals erred in dismissing petitioner's appeal.

Any dismissal of a complaint under the doctrine of *forum non conveniens* or for lack of venue-jurisdiction or the like, necessarily leaves the basic issues unadjudicated. If a suit thus dismissed were refiled in another district in the same circuit there could be a second appeal to the same Court of Appeals. Nevertheless, such dismissals are unquestionably appealable final decisions since they constitute an effective termination of the proceeding in the particular court selected by plaintiff, even though plaintiff may have the right to litigate the same issues against the same defendant in another court.

So, in the case at bar, the District Court's Order of July 29, 1949 effectively terminates petitioner's right to have the issues tried before the District Court for the Eastern District of Virginia and before the Court of Appeals for the 4th Circuit, even though petitioner may still proceed in the District Court for the Northern District of Illinois, Eastern Division.

Furthermore, while it may be true that, as a general rule, orders which dispose of only part of the issues in a case (as for example a decision as to the fact of liability, without any decision as to quantum of damages) are not final appealable decisions, nevertheless, it does not follow that a decision cannot be final and appealable even though something else remains to be done in the case which may be reviewable by a further appeal.

Thus, in the very recent case of *In re Forstner Chain Corp.*, 2d , 83 USPQ (CA-1, decided November 10, 1949) the Court of Appeals for the 1st Circuit held that the District Court's *order denying*[1] *a motion* for the entry of a final decree, was a final and appealable decision within the meaning of Section 1291 of Title 28, United States Code, even though reversal of such order (on appeal) would require entry of the final judgment (requested by the denied motion) from which final judgment another appeal would undoubtedly be taken. The Court in the *Forstner Chain Corp.* case, supra, made the following pertinent statements:

> "His[2] denial of the motion had the element of finality, because he was through with the case and did not, after denying the motion, reserve jurisdiction for the purpose of adjudicating further questions yet undetermined.
>
> . . . . . .
>
> If we should reverse the order, accepting appellant's view that no final judgment in the patent suit has been rendered or entered, then the case would have to be remanded for entry of such final judgment, and no doubt would come back to us on appeal therefrom. The latter consideration has given us some pause, for, on appellant's premise that the district judge has *not* completed final action in the patent case, does it not logically follow that the order appealed from necessarily is interlocutory? But upon the whole it seems more sensible to test the finality by what the district judge thought he was doing. In the order now appealed from he made what he must have regarded as the proper disposition of the plaintiff's motion, and in that view *there were no further proceedings in the case to be had before him*" (F. 2d 83 USPQ 358-9).

So, too, in the case at bar, the District Court's Order of July 29, 1949 did *not* reserve jurisdiction for the purpose of adjudicating any further questions yet unde-

[1] upon the ground that a final judgment had already been entered and the time for taking an appeal therefrom had expired

[2] the District Judge's

termined and, instead, effectively terminated the proceeding before the District Judge, so that *"there were no further proceedings in the case to be had before him"* (*In re Forstner*, supra).

The fact that further proceedings may be had in another District Court, in another Circuit, is believed immaterial from the standpoint of whether or not the District Court's Order of July 29, 1949 was appealable.

Finally, the dislike of piecemeal appeals which motivated the Court of Appeals in dismissing petitioner's appeal, in the case at bar, properly applies only to appeals taken to the *same court.*

In other words, there might have been some justification[1] for dismissal of petitioner's appeal by the Court of Appeals for the 4th Circuit, if, following such dismissal and remand, petitioner would have a right to a subsequent appeal to the Court of Appeals for the 4th Circuit.

The fact of the matter is, however, that the action of the Court of Appeals for the 4th Circuit in dismissing petitioner's appeal meant that petitioner would be relegated to a trial in the District Court for the Northern District of Illinois, Eastern Division, from which an appeal could be taken *not* to the Court of Appeals for the 4th Circuit but, instead, to a different Court, namely the Court of Appeals for the 7th Circuit.

It is submitted, therefore, that there was no possibility of piecemeal appeals to the same Court involved in the case at bar, and that the Court of Appeals' action in dismissing petitioner's appeal upon this principle was erroneous.

Clearly, the difference between *transfer* under Section 1404(a) of Title 28, United States Code and *dismissal* under the old procedure is technical and in fact almost purely verbal; all practical consequences (in a case like the present) of either method of procedure, being identical[2].

---

[1] here assumed for the purpose of this argument, without conceding the point

[2] see *Ettelson* v. *Metropolitan Life Insurance Co.* as quoted hereinbelow at page 21.

Argument—Point 3

Whether or not an order

(entered upon defendant's motion under 28 U.S.C. 1404-a and over plaintiff's objection)

directing transfer of an action properly instituted (and maintainable) in the District of defendant's domicile, to another District and Circuit, is an appealable interlocutory order granting an injunction within the meaning of 28 U.S.C. 1292(1)

(i.e. as an order enjoining plaintiff from proceeding with the action in the District and Circuit of defendant's domicile)

is an important Federal question which has not heretofore been considered or settled by this Court, and which has been passed upon by the Court of Appeals in this case in a way probably in conflict with the applicable analogous decisions of this Court

(which are to the effect that an interlocutory order which prevents a litigant from relying on important substantive rights involved in the trial of a pending action in an appealable interlocutory decree granting an injunction).

It is petitioner's contention that, if the District Court's order (R.p. 72) dated July 29, 1949, was not a final decision within the meaning of Section 1291 of Title 28, United States Code (i. e. as a decision finally terminating the action in the District and Circuit selected by petitioner) then it was an interlocutory order granting an injunction such as was appealable under Section 1292(1) of Title 28, United States Code, which provides, inter alia, that courts of appeals shall have jurisdiction of appeals from

> "Interlocutory orders of the district courts of the United States, . . . or of the judges thereof, granting . . . injunctions, . . ."

That is, petitioner contends that the aforesaid order of July 29, 1949 entered in this case constituted an appealable interlocutory order granting an injunction since the order effectively enjoined and restrained petitioner from proceeding with the action in the District and Circuit selected by him (and, instead, relegated petitioner to proceeding in another District and Circuit wherein, as will

be discussed hereinbelow under *Argument—Point 4*, the Courts have handed down decisions unfavorable to petitioner's view of the case).

The decision (R.pp. 123-126; reported at 177 F. 2d 360; 83 USPQ 144) and judgment (R.p. 126) of the Court of Appeals (the review of which is sought by the present petition) held, on the contrary, that the District Court's aforesaid Order of July 29, 1949 was *not* appealable under Section 1292(1) of Title 28, United States Code;—the Court's Opinion summarily disposing of petitioner's contention with the statement that

> "It should require no discussion to demonstrate that an order transferring or refusing to transfer a case for trial is not one granting or denying an interlocutory injunction . . ." (R.p. 125).

It is submitted that this question (which, so far as we are aware, has not heretofore been considered or settled by this Court) is one which merits review by this Court

as constituting an important question of Federal law[1], in that the question will inevitably come up in many cases wherein orders under Section 1404(a) of Title 28, United States Code, are hereafter rendered, so that it is important to the Federal bench and bar to have an early judgment by this Court on the question, and

as being in probable conflict[2] with the applicable decisions of this Court (to be discussed hereinbelow).

We recognize that most pre-trial orders entered by district courts relating to trial procedure are not appealable under Section 1292(1) of Title 28, United States Code.

---

[1] petitioner relies on *Douglas* v. *Cunningham* as authority for the granting of certiorari where the question involved is an important question of Federal law

[2] petitioner relies on *Faulkner* v. *Gibbs*, 338 U.S. (94 L. Ed. 30), as authority for the granting of certiorari where the decision below is in probable conflict with applicable decisions of this Court

This does not mean, however, that no such pre-trial order can be appealable under Section 1292(1) of Title 28, United States Code.

On the contrary, it is submitted that a distinction must be drawn between

> those pre-trial orders which go simply to relatively unimportant procedural steps (without, in any way, affecting the litigant's basic right to a trial in the forum and manner properly selected by him), and
>
> those pre-trial orders which deprive litigant of the right to a trial in the forum and manner properly designated by him and hence may have a far-reaching, if not fully dispositive effect, upon the litigant's chances of succeeding.

The entry of an order coming within the second category is, we submit, clearly an order granting an injunction such as is appealable under Section 1292(1) of Title 28, United States Code (even if it be deemed interlocutory in character).

Thus, in *Enelow* v. *New York Life Insurance Co.* 292 U.S. 379, 381, 383 (79 L. Ed. 440, 442-3), the District Court had entered an order directing that an equitable issue be heard pursuant to Section 274b of the Judicial Code (28 U.S.C. 398) by the Court in advance of the trial by jury at law of any of the legal issues in the case (which was a suit to recover on an insurance policy wherein defendant set up the equitable defense that the policy had been obtained by false and fraudulent statements). This Court held that the District Court's order *was* appealable as constituting an interlocutory decree granting an injunction restraining plaintiff from trying the so-called "equitable defense" to a jury;—this Court saying:

> "It is thus apparent that when an order or decree is made under § 274b, requiring, or refusing to require, that an equitable defense shall first be tried, the court,

> exercising what is essentially an equitable jurisdiction, in effect grants or refuses an injunction restraining proceedings at law precisely as if the court had acted upon a bill of complaint in a separate suit for the same purpose. Such a decree was made in the instant case, and therefore, although interlocutory, it was appealable to the Circuit Court of Appeals under § 129*."

While the *Enelow* case, supra, was decided prior to the adoption of the Federal Rules of Civil Procedure, the same principle was applied under the Federal Rules in the more recent case of *Ettelson* v. *Metropolitan Life Insurance Co.* 317 U.S. 188, 191-2 (87 L. Ed. 178-9). In the *Ettelson* case, *supra,* the plaintiff had instituted suit to recover under an insurance policy and had demanded a jury trial. Defendant had filed a counterclaim asking that the policy be declared void (because of alleged false statements made in the application therefor) and asking that plaintiff be enjoined from further prosecuting the action at law. The District Court had entered an order directing that the counterclaim be disposed of by the Court prior to the jury-trial of the issue made by the complaint and answer. This Court held that the District Court's order was appealable as constituting an interlocutory decree enjoining plaintiff from trying the issues to a jury;—the Court stating:

> "As in the *Enelow* case, so here the result of the District Judge's order is the postponement of trial of the jury action based upon the policies; and it may, in practical effect, terminate that action. It is as effective in these respects as an injunction issued by a chancellor. If the order be found to be erroneous

* Section 129 of the Judicial Code (28 U.S.C. 227), which was in effect when the *Enelow* decision was rendered and which has since been superseded by Section 1292(1) of Title 28, United States Code, was substantially the same in scope as Section 1292(1) and provided, inter alia: "Where, upon a hearing in a district court, . . . an injunction is granted . . . by an interlocutory order or decree, . . . an appeal may be taken from such interlocutory order or decree to the circuit court of appeals;— . . ."

it will have to be set aside and the plaintiffs permitted to pursue their action to judgment. The plaintiffs are, therefore, in the present instance, in no different position than if a state equity court had restrained them from proceeding in the law action. Nor are they differently circumstanced than was the plaintiff in the Enelow Case. The relief afforded by § 129 is not restricted by the terminology used. The statute looks to the substantial effect of the order made."

It is submitted that, under the decisions of this Court in the *Enelow* and *Ettelson* cases, *supra,* the District Court's order of July 29, 1949, in the case at bar, was an appealable interlocutory decree granting an injunction and that the Court of Appeals for the Fourth Circuit erred in holding to the contrary and in dismissing petitioner's appeal.

We are aware of the decision in *City of Morgantown* v. *Royal Insurance Co.* 337 U.S. 254 (93 L. Ed. 1023), wherein this Court distinguished the *Enelow* and *Ettelson* decisions, in holding non-appealable an order striking a demand for jury trial (in a case wherein plaintiff had brought suit for reformation and correction of an insurance policy and defendant had filed a counterclaim to recover on the policy as written and demanded a jury trial on the counterclaim).

The basis for the decision in the *City of Morgantown* case was this Court's conclusion that, since there were no longer separate courts of law and equity following the adoption of the Federal Rules of Civil Procedure, the order striking the demand for jury trial could not be considered as analogous to the action of a "chancellor" enjoining a "judge" of another court having cognizance of a pending action at law.

In other words, the *City of Morgantown* decision distinguished the *Enelow* and *Ettelson* cases solely on the basis that, insofar as concerns any order granting or denying a jury trial in *that particular court,* it was no

longer possible, under the Federal Rules of Civil Procedure, to draw the analogy to a judge of one court entering an order granting an injunction affecting the trial in another court.

It is apparent that this distinction does *not* apply in the case at bar since there *are,* in fact, two separate and distinct courts involved in the case at bar.

Thus, the order of July 29, 1949 entered by the District Court for the Eastern District of Virginia not only restrains petitioner from proceeding to trial in *that* Court but also acts as a *mandatory injunction* compelling petitioner to litigate and proceed to trial in a *separate and distinct court,* namely the District Court for the Northern District of Illinois, Eastern Division (indeed, in a different Circuit).

By way of illustration, if respondent, Stewart-Warner Corporation had, subsequent to the filing of the complaint at bar, instituted suit against petitioner in the District Court for the Northern District of Illinois, Eastern District, seeking declaratory judgment of petitioner's Johnson patent 2,040,177 and if the District Court for the Eastern District of Virginia had then entered an order enjoining further prosecution of the action in the Northern District of Illinois, such an order would clearly have been appealable under Section 1292(1) of Title 28, United States Code, or under Section 129 of the Judicial Code (28 U.S.C.A. 227) which Section 1292(1) superseded. See, for example, the following cases:

Triangle Conduit & Cable Co. v. *National Electric Products Corp.,* 125 F. 2d 1008, 1009 (CCA 3), certiorari denied 316 U.S. 676 (86 L. Ed. 1750)

Crosley Corp. v. *Westinghouse Electric & Mfg. Co.,* 130 F. 2d 474, 475 (CCA 3), certiorari denied 317 U.S. 681 (87 L. Ed. 546)

Crosley Corp. v. *Hazeltine Corp.,* 122 F. 2d 925, 927 (CCA 3)

Cresta Blanca Wine Co. v. *Eastern Wine Corp.,* 143 F. 2d 1012, 1014-5 (CCA 2)

See also *Tivoli Realty* v. *Interstate Circuit*, 167 F. 2d 155, 157 (CCA 5), certiorari denied 334 U.S. 837 (92 L. Ed. 1716), as discussed hereinbelow (pp. 32-3) wherein the Court in considering an appeal from an order of the District Court for the Northern District of Texas enjoining prosecution of an action pending in the District Court for the District of Delaware stated:

> "The appeal is authorized by Section 129 of the Judicial Code, 28 U.S.C.A. § 227."

Since Section 1292 (1) of Title 28, United States Code, makes appealable interlocutory orders denying injunctions as well as interlocutory orders granting injunctions, any order entered by the District Court for the Eastern District of Virginia, in the case at bar, which would have refused an injunction against such a declaratory judgment action in the Northern District of Illinois and which would have directed that the Virginia action be held in abeyance until the Illinois action was adjudicated would likewise have been appealable under Section 1292(1).

The effect of the District Court's order of July 29, 1949, in the case at bar, directing transfer of this action to the Northern District of Illinois is *exactly* the same as that of an order which would have refused to enjoin a declaratory-judgment action in the Northern District of Illinois and would have directed that the Virginia action be held in abeyance so that the issues could be tried in the Northern District of Illinois, instead, and, since the latter type of order would clearly have been appealable under Section 1291(1), it is submitted that the order actually entered on July 29, 1949 in this case was likewise appealable since, as stated in *Ettelson* v. *Metropolitan Life Insurance Co.*, supra:

> "The relief afforded by §§ 129 is not restricted by the terminology used. The statute looks to the substantial effect of the order made."

Additionally, the aforesaid order of July 29, 1949 of the District Court in the case at bar, not only restrains petitioner from appealing to the Court of Appeals for the 4th Circuit on the merits, if necessary, but also acts as a mandatory injunction compelling petitioner to take any such appeal as may be necessary to the Court of Appeals for the 7th Circuit.

It is clear, therefore, that the case at bar is controlled by the *Enelow* and *Ettelson* decisions (rather than by the *City of Morgantown* decision) as well as the other cases discussed above and that under these decision the District Court's order of July 29, 1949 was appealable as an interlocutory decree granting an injunction so that the dismissal of petitioner's appeal by the Court of Appeals for the 4th Circuit was erroneous.

This Court has recognized that a litigant should not be compelled to proceed with a costly and time-consuming trial where he is entitled to trial in a different manner or in a different Court. See, for example, *Matter of Simons* 247 U. S. 231, 239-240 (62 L. Ed. 1094, 1096); *Matter of Skinner & Eddy Corp.* 265 U. S. 86, 95-6 (68 L. Ed. 912-915) and *Los Angeles Brush Mfg. Corp.* v. *James* 272 U. S. 701, 706, 708 (71 L. Ed. 481, 483-4).

Certainly, the parties should not be compelled to proceed with a lengthy and expensive trial in the District Court for the Northern District of Illinois and an appeal to the Court of Appeals for the 7th Circuit if the fact is that petitioner is entitled to a trial in the District Court for the Eastern District of Virginia and an appeal to the Court of Appeals for the 4th Circuit.

Argument—Point 4

Whether or not a District Judge can (without abusing his discretion) direct transfer of an action properly instituted (and maintainable) in the District of defendant's domicile, to another District and Circuit

(4-a) upon controverted moving affidavits alleging that such a transfer would be for the "convenience of parties and witnesses",

(4-b) in the face of plaintiff's uncontroverted affidavits showing that the transfer would be prejudicial to it on the merits of the case and hence would not be in the "interest of justice",

is an important Federal question which has not heretofore been considered or settled by this Court and which the District Court and the Court of Appeals in the case at bar have decided in a manner probably in conflict with the analogous decisions of this Court and the Courts of Appeal for other Circuits interpreting the doctrine of "forum non conveniens".

It is petitioner's contention that Section 1404(a) of Title 28, U. S. Code requires a District Judge to consider "the interest of justice" as an element separate and distinct from any alleged "convenience of parties and witnesses" before he can properly enter an order directing transfer to another District in another Circuit of a properly instituted action pending before him, and that

Point 4-a) where, as in the case at bar, the showing (by way of ex-parte affidavits) of alleged "convenience of parties and witnesses" is inconclusive and is controverted (by answering affidavits indicating no unusual inconvenience in proceeding in the forum selected by the plaintiff),

and

Point 4-b) where, as in the case at bar, the transfer sought by defendant would *not* be in the "interest of justice" (because it would require the plaintiff to try the action in a District and Circuit wherein the Courts have rendered decisions unfavorable to plaintiff on fact-issues involved in the case).

an order directing transfer constitutes an abuse of discretion such as should be corrected upon appellate review.

Argument of Point 4-a

The Court of Appeals for the 4th Circuit, on the other hand, held that "the appeal should be dismissed as presenting no question of substance for our consideration . . . Whether the judge below should have removed the case was a matter resting in his sound discretion . . . and there is nothing in the record to indicate that the discretion was abused. In this posture of the case, there is no reason why we should entertain an appeal lacking in all substance" (R.p. 125; 177 F. 2d 362-3; 83 USPQ 146).

It is submitted that this question (namely whether, and under what circumstances, there can be an abuse of discretion in directing transfer of a case to another District in another Circuit under the provisions of Section 1404(a) of Title 28, United States Code), is one which, so far as we are aware, has not heretofore been considered or settled by this Court and which merits review by this Court

as constituting an important question of Federal law[1]

as being in probable conflict[2] with the applicable decisions of this Court (to be discussed hereinbelow), and

as being in conflict[3] with the decisions (to be discussed hereinbelow) of the Courts of Appeal for other Circuits and of other District Courts.

---

[1] petitioner relies on *Douglas* v. *Cunningham*, 294 U.S. 207, 209 (79 L. Ed. 862, 864), as authority for the granting of certiorari where the question involved is an important question of Federal law

[2] petitioner relies on *Faulkner* v. *Gibbs*, 338 U.S. (94 L. Ed. 30), as authority for the granting of certiorari where the decision below is in probable conflict with applicable decisions of this Court

[3] petitioner relies on *Jungersen* v. *Ostby and Barton Co.*, 335 U.S. 560 (93 L. Ed. 232, 234), and *Mandel Bros.* v. *Wallace*, 335 U.S. 291 (93 L. Ed. 11, 12), as authority for the granting of certiorari where the Court of Appeals' decision below is in conflict with the decisions of Courts of Appeals for other Circuits

As pointed out on pages 3 & 4 of the Petition, the ex parte affidavits upon which respondent based its motion to transfer this case to the United States District Court for the Northern District of Illinois, Eastern Division, were directed solely to the question of "convenience" of parties and witnesses. These ex parte affidavits were controverted by answering affidavits indicating no particular inconvenience to respondent in defending the present action in the State and District in which respondent is incorporated and has its statutory office and statutory agent, even though most of its activities may be conducted in Chicago.

Thus, in the answering affidavits submitted on behalf of petitioner (R.p. 49) it was pointed out that many of respondent's books and records had already been photocopied or otherwise reproduced and were in the custody of the Clerk of the District Court for the District of North Dakota so that they can be as readily available in Richmond (R.p. 49) as in Chicago, and that, in all probability, very few witnesses and very little additional material would be required from Chicago in connection with the trial of this action in Richmond (R.pp. 49-50 & 51).

It is submitted that Section 1404(a) of Title 28, United States Code, contemplates a much more conclusive and convincing showing of "convenience" than was made out in this case.

Certainly, in enacting Section 1404(a), Congress did not contemplate that the choice of forum should be taken from the plaintiff and placed in the hands of the defendant. In other words, Congress contemplated some real and substantial showing of "inconvenience" in the forum selected by plaintiff and of correspondingly greater "convenience" in the forum designated by the defendant. Neither of these elements is present in the case at bar under the showing made by respondent's affidavits and petitioner's answering affidavits so that, even if there were no considerations of "interest of justice" involved, the District Court should *not* have

directed transfer of this action to the Northern District of Illinois, Eastern Division.

A much more realistic view than that adopted by the Courts below, in the case at bar, is the one stated in the recent case of *Brown* v. *Insurograph*, 85 F. Supp. 328, 330, 331 (DC Del) which involved facts closely similar to those at bar. In the *Brown* case, plaintiff had brought suit in the District of Delaware for declaratory judgment of certain patents owned by defendant which was a Delaware corporation but which had its principal place of business in Birmingham, Alabama. In denying a motion under Section 1404(a) of Title 28, United States Code, for transfer of the case to the Northern District of Alabama, Southern Division, the Court, in the *Brown* case, made the following pertinent statements:

> "Convenience of parties. This question need not be considered at length. The plaintiff is a citizen and resident of Ohio. The intervening plaintiff is a corporation doing business in Texas. They deny that Alabama is a convenient forum to which they should be sent. *The defendant is doing business in Alabama and could have been sued there, but is a corporation of the State of Delaware.* The plaintiff had the choice of at least two forums and selected Delaware. There is no suggestion of harassment in the election. A denial to the plaintiff of the forum of his choice on the ground of convenience of parties should *not* be based solely on the convenience of the defendant and transfer on such ground, over objection, should be based upon a more conclusive showing of convenience than the mere desire of the defendant. Insofar as convenience of the parties themselves is concerned, passing for the moment the convenience of witnesses, it does not appear that transfer should be required.
>
> "Convenience of witnesses. This is primarily a patent litigation. It seems clear that the questions of validity and infringement will involve a number of professional witnesses whose testimony will be both intricate and

lengthy. It is argued that witnesses of this character are to a large extent found in the metropolitan centers of the North and that Delaware is a more convenient forum for them than Alabama. I need not go so far. It may not be said that available expert witnesses are confined to any particular locality and it is not suggested that Alabama is more convenient to this class of witnesses than Delaware."

. . . . . .

"The suggested defense of equitable estoppel might raise different questions. Certain affidavits aver that the plaintiff Brown was one of the promoters and organizers of the defendant corporation; that in this organization he made certain representations with respect to the validity and scope of the defendant's patents, now in suit, and defendant argues this would create an equitable estoppel against him and those claiming under him, which would bar any relief in this action. Since it is alleged that these representations were made in Birmingham, Alabama, it is understandable that witnesses to sustain this defense are to be found in Alabama and that Alabama will be a more convenient forum for those witnesses than Delaware. It is alleged that there are several of such witnesses and these plainly enter into a correct determination of the present motion.

"While the number of witnesses to maintain the equitable defenses, if raised, might somewhat exceed the number of witnesses as to the primary questions of validity and infringement, yet it is thought that the latter questions would consume a far greater period of time and thus create some balance of inconvenience.

"In the interest of justice. No interest of justice as distinct from convenience of parties or of witnesses is here discernible. This is an action for a declaratory judgment involving patent validity and infringement. Jurisdiction is based in the complaint upon the patent

laws of the United States. Jurisdiction is not primarily based upon diversity of citizenship, although such diversity seems, in fact, to exist. Not being based upon diversity, it is not clear that any local law of either Alabama or Delaware would be controlling and it is not now necessary to determine just what effect need be given to such local law. The case does not seem to involve any local questions or have local coloring other than as above mentioned with regard to witnesses.

"*Having in mind that the defendant is a Delaware corporation* and that the plaintiff has elected to exercise his right of selecting Delaware as a forum for the litigation of the difficulties, there does not seem any countervailing balance of convenience or of justice in favor of transferring the case from Delaware to Alabama. In the absence of the transfer statute, I would not feel that the suit should be dismissed under the doctrine of forum non conveniens. Consequently, the motion to transfer is denied and an order may be submitted."

The showing of "convenience" made in the *Brown* case, supra, was much more conclusive than that made out in the case at bar and yet the Court ruled that transfer of the action was not justified.

The Court, in the *Brown* case, supra, pointed out that the standards or criteria to be applied in connection with motions for transfer under Section 1404(a) of Title 28, United States Code, were those previously enunciated by this Court in governing the determination of dismissal under the doctrine of "*forum non conveniens*" and that, if the "inconvenience" would not have been sufficient to warrant dismissal under the doctrine of "*forum non conveniens*", then it was not sufficient to justify a transfer under Section 1404(a) of Title 28, United States Code.

The Court of Appeals for the 4th Circuit, in the case at bar, on the other hand, held that Section 1404(a) of Title 28, United States Code, grants a power to transfer

which is much broader than, and unrelated to, the power to dismiss under the doctrine of *"forum non conveniens"* (R.pp. 124-5; 177 F. 2d 362; 83 USPQ 145).

It is submitted that the view adopted in the *Brown* case and *not* the view adopted by the Court of Appeals in the case at bar, is the correct one, and that the question of whether or not a transfer should be granted under Section 1404(a) of Title 28, United States Code, should be answered by applying the same standards which were set up by this Court in *Gulf Oil Corp.* v. *Gilbert,* 330 U.S. 501, 508 (91 L. Ed. 1055, 1062). See also *Schoen* v. *Mountain Producers Corp.,* 170 F. 2d 707, 715 (CA-3) wherein the Court, in a footnote, stated:

> "The consideration of these amended motions* by the district courts would, of course, be had in the light of the rules for the application of the doctrine of forum non conveniens laid down by the Supreme Court in *Gulf Oil Corp.* v. *Gilbert,* 1947, 330 U.S. 501, 67 S. Ct. 839, 91 L. Ed. 1055 and *Coster* v. *Lumbermen's Mutual Casualty Co.,* 1947, 330 U.S. 518, 67 S. Ct. 828, 91 L. Ed. 1067."

The principles applicable to dismissal of an action under the doctrine of *forum non conveniens* (which, under the decisions cited above, are also applicable to motions under Section 1404-a of Title 28, United States Code) were stated by this Court as follows in the *Gulf Oil Corp.* case, *supra*:

> "The court will weight relative advantages and obstacles to fair trial. It is often said that the plaintiff may not, by choice of an inconvenient forum, 'vex,' 'harass,' or 'oppress' the defendant by inflicting upon him expense or trouble not necessary to his own right to pursue his remedy. But unless the balance is strongly in favor of the defendant, the *plaintiff's choice of forum should rarely be disturbed.*"

* motions under Section 1404(a) of Title 28, United States Code

See also *Williams* v. *Green Bay & Western R. Co.*, 326 U.S. 549, 554, 559, 560 (90 L. Ed. 311, 315, 318), wherein this Court stated:

> "We mention this phase of the matter to put the rule of forum non conveniens in proper perspective. It was designed as an 'instrument of justice'. Maintenance of a suit *away from the domicile* of the defendant—whether he be a corporation or an individual—might be vexatious or oppressive."
>
> . . . . . .
>
> "Nor can we conclude that the maintenance of this suit in New York will be vexatious or oppressive. Petitioners, as we have said, reside there. While respondent's railroad lines are wholly in Wisconsin, it does business in New York. The Class B debentures are listed and traded in on the New York Stock Exchange. The amounts payable on them in lieu of interest are payable in New York. Respondent maintains its financial as well as a traffic office in New York. It maintains a bank account in New York, not only to take care of obligations under its securities, but also to handle excess operating funds not needed in Wisconsin. Five of respondent's six directors are to be found in New York. These five directors include all the executive and fiscal officers, except the president who supervises operations in Wisconsin and the general auditor who is in Wisconsin. Directors' meetings are customarily held in New York. Two of the three members of the executive committee, which acts for the board between meetings, are to be found in New York. Financial records, transfer books, minute books, and the like are kept in New York. These facts plainly indicate to us that it would not be vexatious or oppressive to entertain this suit in New York, whether the availability of witnesses or any other aspect of a trial be considered. We accordingly conclude that, the requirements of jurisdiction and venue being satisfied (Judicial Code, §§ 24, 51, 28 USCA §§ 41(1), 112, 7 FCA title 28, §§ 41 (1), 112),

the District Court should not have declined to hear and decide the case."

In other words, the doctrine of *forum non conveniens* was conceived to prevent a corporation from being sued in an inconvenient forum *away from its domicile,* and not to prevent suit from being instituted against it in the State and Dstrict of is domicile (i.e. its incorporation).

To like effect is *International Milling Co.* v. *Columbia Transportation Co.,* 292 U.S. 511, 521 (78 L. Ed. 1396, 1401-2) wherein this Court stated:

"Such a suit may be a burden, but oppressive and unreasonable it is not."

. . . . . .

"The forum being in other respects appropriate, jurisdiction is not lost . . . because each of the witnesses on the trial reside in other states, most of them, in seems, in Chicago, Illinois."

In *Canadian Pacific Ry. Co.* v. *Sullivan,* 126 F. 2d 433, 439-440 (CCA-1), certiorari denied 316 U.S. 696 (86 L. Ed. 1766), it was held that no unreasonable burden was placed upon defendant (a Canadian corporation) by subjecting it to suit in Massachusetts (wherein plaintiff resided). How much stronger is the case against respondent in the action at bar which was instituted in the very State and District which defendant itself selected as its place of domicile and residence!

It is submitted that where a company chooses to incorporate itself under the laws of a given State, the very fact of such incorporation constitutes an implied assent to being sued there and precludes the corporation from contending that a suit in that State and District would be so "inconvenient" to it as to justify a transfer to a District Court located in another State and in another Circuit.

In other words, the allegation of "inconvenience" asserted by respondent at bar is, we submit, unalterably irreconcilable with the fact that respondent itself selected

the State of Virginia as its state of incorporation and located its statutory office and statutory agent in Richmond, within the Eastern District of Virginia.

A case directly in point is *Tivoli Realty* v. *Interstate Circuit,* 167 F. 2d 155, 157 (CCA 5), certiorari denied 334 U.S. 837, (92 L. Ed. 1762), which was an appeal from an interlocutory order of the District Court for the District of Texas enjoining appellees from prosecuting an action pending in the District for the District of Delaware;—the injunctive order having been issued under the doctrine of *forum non conveniens.* The Delaware action had been instituted by Tivoli Realty Company, a Texas corporation, against fourteen defendants (of which ten were Delaware corporations and the remaining four were New York corporations) and charged violations of the anti-trust laws. Before answering in the Delaware action, two of the defendants there, including Interstate Circuit, had filed suit in the Northern District of Texas against Tivoli Realty to enjoin the latter from prosecuting the Delaware action. Seven of the remaining twelve defendants in the Delaware action had intervened in Texas and had joined in the prayer for an injunction. The remaining five defendants in the Delaware suit filed a paper in the Texas District Court denying that the Court had jurisdiction over them but voluntarily offering to submit to its venue if the Delaware complaint were brought in Texas. These five corporations did not, however, file any intervention and did not offer any evidence or ask any relief.

The Texas District Court had entered an order granting the temporary injunction from which appeal was taken to the Court of Appeals for the Fifth Circuit;—the latter Court holding that:

> "The appeal is authorized by Section 129 of the Judicial Code, 28 U.S.C.A. §227" (167 F. 2d 155).

In holding that the injunction was improperly granted, the Court of Appeals for the 5th Circuit made the following pertinent statements:

> "*It is a fair inference that ordinarily one's domicile is not an inconvenient place for one to be sued.* Every federal venue statute within our contemplation embraces the defendant's residence or domicile as one of the places for suits to be brought against him. The Clayton Act, supra, specially provides that any action under it against a corporation may be brought in any judicial district where it is an inhabitant, or wherein it may be found, or transacts business. Prima facie, therefor, it is not vexatious or oppressive, within the doctrine under consideration, to sue a corporation within the judicial district that meets not only one but all three of these several requirements as to venue. The Delaware action meets all three, since the appellees may be found in Delaware, transact business there, and *a corporation is deemed to be an inhabitant of the state of its creation.* (Citing Shaw *v.* Quincy Mining Co., 145 U.S. 444, 12 S. Ct. 935, 36 L. Ed. 768; Galveston, etc. *v.* Gonzales, 151 U.S. 496, 14 S. Ct. 401, 38 L. Ed. 248; In re Keasbey & Mattison, 160 U.S. 221, 16 S. Ct. 273, 40 L. Ed. 402; Macon Grocery Co. *v.* Atlantic Coast Line R. Co., 215 U.S. 501, 30 S. Ct. 184, 54 L. Ed. 300.)"

Under the principles laid down in the *Tivoli* case, supra, it is submitted that a corporation which is sued in the State of which it is a citizen and inhabitant (namely, its State of incorporation) should not be permitted indiscriminately to transfer actions brought against it, to another Court located in another District, State and Circuit, simply upon a showing that it does most of its business in such other District and that most of its records and employees are located there, while the controverting affidavit shows that this does not in fact create any unusual inconvenience to the movant. This applies, *a fortiori,* where as in the case at bar, the requested transfer would not be in the "interest of justice" because the decisions of the Court in such *other* District have ruled on certain relevant fact-questions in a manner unfavorable to plaintiff's view of the case.

Argument of Point 4-b

The "interest of justice" requires that the case at bar be tried in the District selected by plaintiff-petitioner (namely, the Eastern District of Virginia), not only because, as pointed out above, the Courts in the Northern District of Illinois and the Seventh Circuit have heretofore passed on relevant fact questions in a manner unfavorable to plaintiff's view of the case but also because public policy dictates a free and unhampered choice of forum to a patentee whose patent is being infringed indiscriminately in many different States.

Thus, it is in the interest of justice that a patentee be free to sue for infringement in at least two different Circuits of his choice. Indeed, the most common ground for granting certiorari in patent cases is conflict of decisions of Courts of Appeal for different Circuits. See *Jungersen* v. *Ostby and Barton Co.,* supra, and *Mandel Bros.* v. *Wallace,* supra. See also *Schriber-Schroth Co.* v. *Cleveland Trust Co.,* 305 U.S. 47, 50 (83 L. Ed. 34, 36) and *Paramount Publix Corp.* v. *American Tri-Ergon Corp.,* 294 U.S. 477, (79 L. Ed. 1005); 293 U.S. 587 (79 L. Ed. 682); 293 U.S. 528 (79 L. Ed. 638), wherein the Court granted certiorari because it appeared that, contrary to usual practice, all of the litigation on the patent in question was being conducted in a single Circuit.

There are particularly compelling reasons why plaintiff-petitioner's choice of forum (i. e. the District Court for the Eastern District of Virginia) should not be disturbed in the case at bar.

Thus, one of the issues in this case is whether defendant-respondent Stewart-Warner Corporation is liable for infringement committed prior to the May 12, 1936 issue date of petitioner's Johnson patent 2,040,177.

Another issue in this case is the anticipatory effect, if any, of alleged prior-use of defendant-respondent's "Alemite" couplers.

As pointed out hereinabove (pp. 3-4) defendant-respondent Stewart-Warner Corporation surreptitiously acquired knowledge of petitioner's patent-application

shortly after it was filed in the United States Patent Office and long before the May 12, 1936 issue-date upon which the patent was actually granted to petitioner and, thereafter (but still prior to the issuance of the patent) Stewart-Warner Corporation was formally advised of the allowance of claims in such pending patent-application, in a formal pleading.

Nevertheless, Stewart-Warner Corporation deliberately copied the Jiffy hydraulic coupler (as subsequently covered by Johnson patent 2,040,177) and made very substantial sales of its infringing product prior to the May 12, 1936 issue date of the patent.

The Court of Appeals for the 4th Circuit has held that, where there has been such a prior disclosure of the subject matter of a pending patent-application, the infringer is under an especially heavy burden to establish his alleged prior use by clear and convincing evidence, beyond a reasonable doubt, and that, moreover, the infringer is liable for infringement committed prior to the issuance of the patent but subsequent to the date upon which he received knowledge of the pendency of the patent-application.

Thus, in *Hoeltke* v. *C. M. Kemp Mfg. Co.*, 80 F. 2d 912, 913 (CCA-4), certiorari denied 298 U.S. 673 (80 L. Ed. 1385), the Court of Appeals for the 4th Circuit held favorably to plaintiff-petitioner's position at bar on both of the above points;—that Court stating:

> "where, in advance of the granting of a patent, an invention is disclosed to one who, in breach of the confidence thus reposed, manufactures and sells articles embodying the invention, such person should be held liable for the profits and damages resulting therefrom, not under the patent statutes, but upon the principle that equity will not permit one to unjustly enrich himself at the expense of another.
>
> . . . . . .
>
> "Defendant argues, however, that in the manufacture and sale of automatic fire checks prior to the grant of

the patent, it was not using the ideas of complainant, but ideas which had been evolved in its own plant prior to the disclosure; and it introduces evidence tending to show that as far back as 1918 it was working on the idea, that in 1926 it had drawings and patterns made for the development of an automatic fire check, and that early in 1929, before it received the specification and drawings of complainant's patent, it had developed in its own plant the fire check with the wire fuse which we have held to be an infringement. Defendant concedes, however, that it is not entitled to claim priority over complainant; and we think that the same rules of evidence which would preclude it from claiming to be the prior inventor of the device constitute a complete answer to the contention that in manufacturing the device it was using its own ideas and not ideas gained from complainant. It is well settled that where an unpatented device, the existence and use of which are proven only by oral testimony, is set up as a complete anticipation of a patent, the proof sustaining it must be clear, satisfactory, and beyond a reasonable doubt. The Barbed Wire Patent, 143 U.S. 275, 284, 12 S. Ct. 450, 36 L. Ed. 154; Adamson *v.* Gilliland, 242 U.S. 350, 37 S. Ct. 169, 61 L. Ed. 356. And we think the same rule should be applied against one who admittedly receives a disclosure from an inventor, proceeds thereafter to manufacture articles of similar character, and, when called to account, makes answer that he was using his own ideas and not the ideas imparted to him."

And, in *Chesapeake & Ohio Ry. Co.* v. *Kaltenbach*, 124 F. 2d 375, 376-7 (CCA 4), the Court of Appeals for the 4th Circuit again similarly held:

"By virtue of the breach of trust involved in this case, and the circumstances under which the defendant appropriated the ideas of the plaintiffs, we agree with the court below that the period for which these royalties are computed should begin at the time the

defendant appropriated the ideas of the plaintiffs and began to use equipment embodying these ideas. This seems fairer than the contention of the defendant that royalties should be charged only from the subsequent date of the issuance of the patents."

Transfer of this action to a District Court in another Circuit, would deprive petitioner of the right to rely on these two last-mentioned decisions (which would, of course, be controlling if the action were tried in the District Court for the Eastern District of Virginia).

Additionally, and even more important, the transfer of this action to the District Court for the Northern District of Illinois, Eastern Division, would result in this case being tried in a District and Circuit wherein the courts have heretofore passed on questions of fact involved in the action at bar, in a manner unfavorable to petitioner's view of the case.

Thus, in *Stewart-Warner Corp.* v. *LeVally* 15 F. Supp. 571 and 16 F. Supp. 778 and 31 U.S.P.Q. 195 (DC ND Ill) and, on appeal, in *Lincoln Engineering Co.* v. *Stewart-Warner Corp.* 91 F.2d 757 (CCA-7), it was held

(*contrary* to the previous decision of the Court of Appeals for the Eighth Circuit in *Stewart-Warner Corp. v. Jiffy Lubricator Co.** 81 F.2d 786)

that Stewart-Warner's "Alemite" coupler was made in accordance with respondent's Butler patent 1,593,791

and

that said patent 1,593,791 was contributorily infringed by hydraulic couplers made in accordance with petitioner's Johnson patent 2,040,177.

In the *Lincoln* case these Courts further held (91 F. 2d 760-5) that said Butler patent did not cover an "old combination" or "aggregation" such as had previously

* the Court of Appeals for the Eighth Circuit had held that Stewart-Warner's "Alemite" hydraulic coupler placed on the market in 1933 and petitioner's "Jiffy" hydraulic coupler placed on the market in 1930 were clear mechanical equivalents, and that both were "a departure and different from the real disclosure of" Butler patent 1,593,791 (81 F.2d 793)

been condemned by this Court in *Bassick* v. *Hollingshead** 298 U.S. 415 (80 L. Ed. 1251) and *Rogers* v. *Alemite Corp.** 298 U.S. 415 (80 L. Ed. 1251).

The aforesaid decisions of the District Court for the Northern District of Illinois, Eastern Division, and the Court of Appeals for the Seventh Circuit were *reversed* by this Court in *Lincoln Engineering Company of Illinois* v. *Stewart-Warner Corp.* 303 U.S. 545, 82 L. Ed. 1008, wherein it was held that the earlier *Bassick* and *Rogers* decisions of this Court were in fact controlling and that (just as was the case with respondent's Gullborg patent 1,307,734) Stewart-Warner's Butler patent 1,593,791 was invalid as covering an "old combination" and "aggregation" because the claims thereof were not confined to the Butler-improved multi-jawed chuck type coupler specifically defined in the claims, but also included the admittedly old grease-gun and grease-receiving "nipple" which were included in the claims in broad all-inclusive language comprehending *all* grease-guns and *all* nipples of whatever construction.

By way of contrast, neither the District Court for the Eastern District of Virginia nor the Court of Appeals for the 4th Circuit has heretofore passed on any fact-question relevant, pertinent or material to the issues at bar.

It is clear, therefore, that it would *not* be "in the interest of justice" to transfer this action from the District Court for the Eastern District of Virginia to the District Court for the Northern District of Illinois and that instead, such a transfer would result in serious prejudice to petitioner's chances of prevailing, as compared to its chances of prevailing in the District and Circuit of petitioner's choice.

If the statutory requirement that a requested transfer be "in the interest of justice" has any significance whatever (over and above the requirement that the transfer be "for the convenience of parties and wit-

* wherein respondent's Gullborg patent 1,307,734 had been held invalid or unenforceable as covering an "exhausted combination" and "aggregation" of a coupler and a fitting whereas the invention, if any, had resided in the coupler alone

nesses") then, it is submitted that the District Court for the Eastern District of Virginia and the Court of Appeals for the 4th Circuit clearly erred in holding that this action should be transferred to the District Court for the Northern District of Illinois, Eastern Division.

Stating it somewhat differently, the position taken by the District Court and the Court of Appeals in the case at bar can be correct *only if* Section 1404(a) of Title 28, United States Code does *not* contemplate any showing of "interest of justice" over and above the "convenience of parties and witnesses".

Such an interpretation obviously is at variance with the principles followed by this Court in previously applying the doctrine of *"forum non conveniens"* and, under the decisions discussed hereinabove, it is submitted that Congress did *not* contemplate any such departure from the *"forum non conveniens"* doctrine in enacting Section 1404(a) and that, therefore, the Courts below erred in holding that respondent's requested transfer of this action was proper.

A case directly in point on the granting or denial of a motion under Section 1404(a) of Title 28, U. S. Code, where the law in the other District, to which transfer is sought, is less favorable to the opposing party, is *Bolten* v. *General Motors Corp.* 81 F. Supp. 851, 852 (DC ND Ill) wherein plaintiff had brought suit for damages based on alleged negligence and defendant had moved for summary judgment based on the affirmative defense that the action was barred by the two-year Illinois Statute of Limitations. Thereupon, plaintiff moved for leave to dismiss the complaint without prejudice or, in the alternative, to have the case transferred to Missouri under Section 1404(a) of Title 28, U. S. Code. The applicable Missouri Statute of Limitations was five years which would *not* have barred the action if tried in the Federal District Court located in Missouri.

Recognizing that the requested transfer would deprive defendant of the defense of the Statute of Limitations and hence would work an injustice on defendant, the Court, in the *Bolten* case, supra, *denied* the motion

under Section 1404(a) of Title 28, U. S. Code, and *granted* defendant's motion for summary judgment.

It is apparent, even at this early date, that Section 1404(a) of Title 28, United States Code, will be invoked by litigants with great frequency. Indeed, examination of Shepard's United States Citations through the November, 1949 Advance Sheet shows that, in the little over the one-year life of the Statute, it has been cited some 30 times.

Among the reported decisions, the following are cases in which the lower Federal Courts have *refused* to transfer pending actions to other Districts in other Circuits in the absence of any conclusive showing that such a transfer would be in the interest of justice, especially where "convenience" to defendant is not particularly great or is doubtful:

Auburn Capitol Theatre Corp. v. *Schine Chain Theatres,* 83 F. Supp. 872 (D. C. S. D. N. Y.)

Perry v. *Atchison T. & S. F. Ry. Co.,* 82 F. Supp. 912, 913 (D. C. N. D. Cal.)

Bolten v. *General Motors Corp.,* 81 F. Supp. 851, 852 (D. C. N. D. Ill.)

Levenson v. *Little,* 81 F. Supp. 513, 517 (D. C. S. D. N. Y.)

Brown v. *Insurograph,* 85 F. Supp. 328, 330-1 (D. C. Del.)

Obviously, the fact that the District Court is given discretion in granting or denying motions under Section 1404(a) of Title 28, United States Code, does not mean that there cannot be an abuse of discretion and does not mean that there is no right to appellate review from a District Court order entered under Section 1404(a).

It is submitted that, upon the facts at bar, there was a clear and direct showing that the requested transfer would *not* be in the interest of justice (because the transfer would be prejudicial to plaintiff on the merits of the case) and that, therefore, the directed transfer constituted an abuse of discretion on the part of the District Court which should be corrected by this Court in view of the importance of the question involved from the standpoint of the administration of justice in the lower Federal Courts.

Argument—Point 5

In view of importance of foregoing Question 4, this Court should review the District Court's order of July 29, 1949, by way of writ of mandamus or certiorari, under its power of supervision of the lower Federal Courts, if this Court deems that the aforesaid order of July 29, 1949 was not appealable to the Court of Appeals for the 4th Circuit, under either Section 1291 or Section 1292(1) of Title 28, United States Code.

It is submitted that, in view of the importance of the questions involved (as hereinabove shown), this Court should review the District Court's order of July 29, 1949 by way of mandamus or certiorari even if it deems said order was not appealable either under Section 1291 nor under Section 1292(1) of Title 28, United States Code.

The importance of an early interpretation of Section 1404(a) of Title 28, United States Code, has heretofore been recognized by this Court and, as a result, this Court has given consideration to petitions for writ of certiorari and/or mandamus directed to District Court orders, even though no claim was made that such orders were appealable. See *Ex parte Collett; Kilpatrick* v. *Texas and Pacific Railway Co.;* and *United States* v. *National City Lines;* all *supra.*

And, this Court has intervened by way of writ of mandamus or certiorari to grant relief against orders which would require a litigant to proceed with a costly and time-consuming trial where he is entitled to a trial in a different manner or in a different Court.

Thus, in *McClellan* v. *Carland,* 217 U.S. 268, 280 (54 L. Ed. 762, 766), this Court granted certiorari and reversed an order of the Court of Appeals denying a petition for mandamus to compel the District Judge to proceed with and determine an action in that Court (the District Judge having stayed the action to await the commencement and prosecution to conclusion of a suit in a State Court). This Court held that mandamus was a proper remedy, even though it appeared that an appeal could have been filed to the Court of Appeals;—this Court stating:

"But we think it the true rule that where a case is within the appellate jurisdiction of the higher court, a writ of mandamus may issue in aid of the appellate jurisdiction which might otherwise be defeated by the unauthorized action of the court below. This rule was distinctly stated and the previous cases referred to in Knickerbocker Ins. Co. *v.* Comstock, 16 Wall. 258, 270, 21 L. ed. 493, 498. In that case the rule was recognized that this court had the power to issue the writ of mandamus to compel the circuit courts to proceed to final judgment in order that this court may exercise the jurisdiction or review given by the law. In that case the court said:

'Repeated decisions of this court have established the rule that this court has power to issue a mandamus, in the exercise of its appellate jurisdiction, and that the writ will lie in a proper case to direct a subordinate Federal court to decide a pending cause.'"

In *Matter of Simons* 247 U.S. 231, 239-240 (62 L. Ed. 1094, 1096), this Court had before it a "petition for mandamus, or, if that is denied, for prohibition or certiorari" to review the District Court's order to transfer an action to the equity side of the Court. In granting the petition this Court, speaking through Mr. Justice Holmes, made the following pertinent statement:

"If we are right, the order was wrong and deprived the plaintiff of her right to a trial by jury. It is an order that should be dealt with now, before the plaintiff is put to the difficulties and the courts to the inconvenience that would be raised by a severance that ultimately must be held to have been required under a mistake. It does not matter very much in what form an extraordinary remedy is afforded in this case. But, as the order may be regarded as having repudiated jurisdiction of the first count, mandamus may be adopted to require the district

court to proceed and to give the plaintiff her right to a trial at common law. See Brown *v.* Buck, 75 Mich. 274, L. R. A. 226, 13 Am. St. Rep. 438, 42 N. W. 827."

In *Ex parte United States* 287 U.S. 241, 246 (77 L. Ed. 283, 285), this Court granted a writ of mandamus requiring a District Judge to set aside an order denying a petition for the issue of a bench warrant. In holding that it had jurisdiction to issue the writ, this Court stated:

"We prefer, however, to put our determination upon the broader ground that, even if the appellate jurisdiction of this court could not in any view be immediately and directly invoked, the issue of the writ may rest upon the ultimate power which we have to review the case itself by certiorari to the circuit court of appeals in which such immediate and direct appellate jurisdiction is lodged."

In *Matter of Skinner & Eddy Corp.* 265 U.S. 86, 95-96 (68 L. Ed. 912, 915), this Court held that it had the right to grant mandamus directed to the Court of Claims and, speaking through Mr. Chief Justice Taft, stated:

"It only remains to inquire whether this is a proper case for the writ asked. Mandamus is an extraordinary remedial process which is awarded, not as a matter of right, but in the exercise of a sound judicial discretion. Although classed as a legal remedy, in issuing it a court must be largely controlled by equitable principles. Duncan Townsite Co. *v.* Lane, 245 U.S. 308, 312, 62 L. ed. 309, 311, 38 Sup. Ct. Rep. 99; United States ex rel. Arant *v.* Lane, 249 U.S. 367, 371, 63 L. ed. 650, 652, 39 Sup. Ct. Rep. 293. It would be a useless waste of time and effort to enforce a trial in the court of claims if we were, upon appeal, to find that the petitioner was unjustly deprived of his substantial right to dismiss his petition, as we should have to do for the reasons stated. Added to this is the consideration which has been regarded

as furnishing a substantial ground for the extraordinary process of the writ that the petitioner, by a denial of his right to dismiss in the court of claims, will be deprived of a right of trial by jury in the state court of Washington. Ex parte Peterson, 253 U.S. 300, 305, 64 L. ed. 919, 921, 40 Sup. Ct. Rep. 543; Ex parte Simons, 247 U.S. 231, 239, 62 L. ed. 1094, 1096, 38 Sup. Ct. Rep. 497."

In *Los Angeles Brush Mfg. Corp.* v. *James* 272 U. S. 701, 705-708 (71 L. Ed. 481, 483-484), this Court considered a petition for mandamus against a District Judge directing that the suit (for patent infringement) be tried before a Master in order to ease the congestion of the Court's calendar, which included a large number of criminal cases entitled to preferential treatment as to order of trial. While denying the motion because it appeared that there had been no abuse of discretion, the Court, again speaking through Mr. Chief Justice Taft, made the following pertinent statements:

"The hearing of these causes in review would normally be held in the circuit court of appeals of the ninth circuit and they could only come here in due course by applications for certiorari and the granting of them. We do not need to decide whether the intervention between this court and the district court of an intermediate appellate court would prevent the issue of mandamus by this court direct to the district court in matters in which the circuit court of appeals would or should ordinarily have power to issue a mandamus to the same end in aid of its appellate jurisdiction. However that may be, we think it clear that where the subject concerns the enforcement of the equity rules which by law it is the duty of this court to formulate and put in force, and in a case in which this court has the ultimate discretion to review the case on its merits, it may use its power of mandamus and deal directly with the district court in requiring it to conform to them. Ex

parte abdu, 247 U. S. 27, 28, 62 L. ed. 966, 967, 38 Sup. Ct. Rep. 447; Ex parte Crane, 5 Pet. 190, 192-194, 8 L. ed. 92-94."

. . . . . .

"One of the causes for complaint of the general administration of justice is the expense it entails upon the litigants, and so far as it reasonably may do so, this court is anxious to minimize the basis for such complaints. There is no reason why a patent litigant should be subjected to any greater expense than any other litigant except as it may be involved in the inherent and inevitable difference between the presentation of the issues as to the merit and validity of a patent grant and that which obtains in the litigation of an ordinary bill for relief in equity or of an action at law upon a debt or for a tort."

It is clear, therefore, that this Court has the right to review the District Court's order of July 29, 1949 by way of writ of mandamus or certiorari even if it decides that said order was not appealable to the Court of Appeals for the 4th Circuit and it is submitted that, in view of the importance of the questions involved (i. e. the interpretation of the *"interest of justice"* provision of Section 1404(a) of Title 28, United States Code and the nature and extent of a District Judge's discretion in granting the transfer of a pending action to another District in another Circuit, under said section), the present petition should be granted to the end that the District Court's order be reviewed and set aside, if found to have been erroneously entered.

Conclusion

In conclusion, it is respectfully submitted that the present petition is one which should be granted by this Court as involving questions of general importance in the administration of justice in Federal Courts, namely:

whether or not an order entered under Section 1404(a) of Title 28, United States Code, directing

transfer of a pending action to another District in another Circuit is appealable either as a final decision within the meaning of Section 1291 of Title 28, United States Code or as an interlocutory order granting an injunction under Section 1292(1) of Title 28, United States Code, and

whether or not such an order entered under Section 1404(a) of Title 28, United States Code, directing transfer of a pending action to another District in another Circuit constitutes an abuse of discretion where it was entered solely on the basis of a controverted showing of "convenience" and in the face of an uncontroverted showing that the transfer would be prejudicial to plaintiff (in that the Courts of the District and Circuit to which transfer was ordered had theretofore passed on questions of law and fact relevant to the trial of the case in a manner unfavorable to plaintiff) and hence would *not* be in the "interest of justice".

Petitioner therefore respectfully submits that, for each of the "Reasons Relied on for Allowance of Writ" (as set out on pages 13-21 of the Petition) as covered by the correspondingly-numbered Argument-Points (set forth hereinabove in this Brief), this case is one in which a writ of certiorari or mandamus should be granted.

Respectfully submitted,

LEONARD L. KALISH,
WILLIAMS, MULLEN & HAZELGROVE,
LITTLETON M. WICKHAM,
GUY B. HAZELGROVE,
attorneys for petitioner

FILE COPY

FILED
JAN 21 1950
CHARLES ELMORE CROPLEY
CLERK

In the

Supreme Court of the United States

October Term, 1949

No. 460

JIFFY LUBRICATOR COMPANY, INC.,
Petitioner,

v.

STEWART-WARNER CORPORATION,
Respondent.

Respondent's Brief In Opposition To Petition for Writ of Certiorari and in Opposition To Petition for Writ of Mandamus or Certiorari

WINSTON, STRAWN, SHAW & BLACK
First National Bank Building
Chicago, Illinois

HINKLE, HORTON, AHLBERG, HANSMANN & WUPPER
2300 Board of Trade Building
LaSalle Street & Jackson Boulevard
Chicago, Illinois

HUNTON, WILLIAMS, ANDERSON, GAY & MOORE
Electric Building
Richmond, Virginia
Counsel for Respondent

JOHN D. BLACK
ELWOOD HANSMANN
THOMAS B. GAY
Of Counsel

TABLE OF CONTENTS

	Page
INTRODUCTORY STATEMENT	1
ARGUMENT	6
POINT I	6
An Order of Transfer Under Section 1404(a) of Title 28 USC Is Not a Final Order and Therefore Not Appealable	
POINT II	13
An Order of Transfer Under Sec. 1404(a) of Title 28 USC, Is Not Appealable Under Sec. 1292(1) of Title 28, As An Interlocutory Injunction	
POINT III	18
There Was No Abuse of Discretion by the Trial Court in Entering the Order of Transfer	
CONCLUSION	23

TABLE OF CASES

Page

Alemite Co. v. Jiffy Lubricator Co., 176 F (2d) 444 2

American Construction Co. v. Jacksonville, T. & K. W. R. Co., 148 U. S. 372, 379, 37 L. Ed. 486, 489 19

Ex Parte American Steel Barrel Co., 230 U. S. 35..... 22

Chesapeake & Ohio Ry. Co. v. Kaltenbach, 124 F. (2d) 375 20

Cinema Amusement Co. v. Loew's, 85 Fed. 319, (D. Del.) 11, 15

Enelow v. New York Life Insurance Co., 293 U. S. 379 .....14, 15

Ettleson v. Metropolitan Life Ins. Co., 317 U. S. 188 14

In re Forstner Chain Corporation, 177 Fed. (2d) 572 .....11, 12

Hoeltke v. C. M. Kemp Mfg. Co., 80 F. (2d) 912 20

Morgantown v. Royal Insurance Co., 93 L. Ed. Adv. Opinions 1023 (1949) 15

Morgantown v. Royal Insurance Co., 169 F. (2d) 713, 715 17

Porta v. Watts, 109 F. (2d) 966 11

Rogers v. Guarantee Trust Co., 288 U. S. 123, 131 8

United States v. Johnston, 268 U. S. 220, 227, 69 L. Ed. 925, 926 19

Text

Moore's Commentary on USC Judicial Code, Sec. 0.03(29) 7, 11

Statutes

Title 28, USC, Section 1291 .....4, 6, 9, 23

Title 28, USC, Section 1292(1) 4, 5, 9, 13, 16, 23

Title 28, USC, Section 1404(a) 2, 4, 5, 6, 8, 9, 12, 13, 16, 23

In the

Supreme Court of the United States

October Term, 1949

No. 460

JIFFY LUBRICATOR COMPANY, INC.,
Petitioner,

v.

STEWART-WARNER CORPORATION,
Respondent.

Respondent's Brief In Opposition To Petition for Writ of Certiorari and in Opposition To Petition for Writ of Mandamus or Certiorari

INTRODUCTORY STATEMENT

In its twenty-one page petition and its forty-six page brief in support thereof, petitioner seems to seek to obscure the simple questions determined by the courts below. Because of this attempted confusion engendered by the intermingling of nonrelated facts and law suits with the questions determined by the lower courts respondent now presents a short review of the record relevant to the real questions involved, together wtih the disposition of the case by the Court of Appeals.

The complaint filed in the United States District Court for the Eastern District of Virginia on July 23, 1948 by Jiffy Lubricator Company, Inc., charged defendant, Stew-

art-Warner Corporation, with infringement of Johnson patent No. 2,040,177.* (R. 1-2). It alleged that Jiffy Lubricator Company, Inc., is a North Dakota corporation having its principal place of business in Fargo, North Dakota (R. 1).

Pursuant to Title 28, USC, § 1404(a) which became effective September 1, 1948, Stewart-Warner Corporation, respondent herein, filed a motion for the entry of an order transferring the cause of action from the United States District Court for the Eastern District of Virginia to the United States District Court for the Northern District of Illinois, Eastern Division (R. 21). An affidavit of James S. Knowlson, President of Respondent, set forth facts which may be summarized as follows: (R. 21)

> (1) The general office and principal factory of Stewart-Warner Corporation are located at Chicago, Illinois, within the Northern District of Illinois, Eastern Division, and the corporation has no office staff, files, factory or books or records concerned with the subjects matter alleged in the complaint within the Eastern District of Virginia.
>
> (2) All of the officers and directors of Stewart-Warner Corporation have their residences and places of business within the Northern District of Illinois, Eastern Division.
>
> (3) The engineering and production design of Stewart-Warner's products charged to infringe the Johnson patent was carried out at Chicago; all of the manufacture of these products occurred at Chicago; and all of the books, records and documents relating to such engineering, design and manufacture together

* This patent has been held invalid by the Court of Appeals for the Eighth Circuit in the recent case of Alemite Co. vs. Jiffy Lubricator Co., 176 F. 2d 444.

with witnesses having knowledge thereof are located at Chicago.

(4) All of the products charged to infringe the Johnson patent were distributed from Chicago and all of the books, records and documents relating to such distribution are in Chicago.

(5) All of the books, records and documents relating to patents, patent applications and patent license contracts to which Stewart-Warner Corporation is a party are located at Chicago.

(6) All of the books, records and documents relating to Alemite Corporation referred to in the complaint are located at Chicago.

(7) All of the books, records and documents relating to the issue of false patent marking asserted in the complaint together with persons having knowledge of such books and records are located at Chicago.

(8) All books, records and documents of Stewart-Warner Corporation relating to its relationship with its distributors as alleged in the complaint are located at Chicago.

(9) All patent counsel and general counsel regularly retained by Stewart-Warner Corporation have their offices at Chicago.

(10) Since all of the books, records and documents, the directors, officers and employees of Stewart-Warner Corporation and its lawyers are located in Chicago in the Northern District of Illinois, Eastern Division, and since none of the books, records, documents or witnesses in any way connected with the subjects matter of the litigation are located within the Eastern District of Virginia and since the plaintiff is a North Dakota corporation with its principal place of business at Fargo, North Dakota, it would be far more convenient for the parties to the litigation to have a trial at Chicago, Illinois rather than at Richmond, Virginia.

The motion for a change of venue was argued before the District Court and on July 29, 1949 which entered an order providing in part:

> " * * * and the Court having considered the arguments of counsel and the affidavits of James S. Knowlson and John D. Black, filed by the Defendant in support of said motion, and of Leonard L. Kalish and August Johnson, filed by the Plaintiff in opposition thereto, and now being of opinion that for the convenience of the parties and witnesses, in the interest of justice, the motion of the Defendant should be granted, it is, therefore,
>
> "Ordered that the venue of this cause be transferred from this Court to the United States District Court for the Northern District of Illinois, Eastern Division * * *." (R. 72)

On August 23, 1949 Jiffy Lubricator Company, Inc., filed its notice of appeal to the United States Court of Appeals for the Fourth Circuit from this order of transfer (R. 73). Subsequently Stewart-Warner Corporation moved to dismiss the appeal and on October 10, 1949 an order to that effect was entered by the United States Court of Appeals for the Fourth Circuit (R. 126). On the same date the Court of Appeals filed an opinion (R. 123, 177 F. 2d 360) holding (1) that an order of transfer pursuant to 28 USC, § 1404(a) was not a final order and was not appealable under 28 USC, § 1291, (2) that an order of transfer did not grant an injunction and was not appealable under 28 USC, § 1292(1), and (3) that even if the order of transfer under 28 USC, § 1404(a) were appealable, the appeal in this case should be dismissed as presenting no question of substance because such an order was one resting in the sound discretion of the trial court and there was

nothing in the record to indicate any abuse of that discretion (R. 125, 177 F. [2] 360).

It thus appears that the *only* action taken by the trial court which is made the subject matter of the petition is the *discretionary* action, based upon a consideration of the relevant facts, *of transferring the venue jurisdiction from the District Court at Richmond, Virginia, to the District Court at Chicago, Illinois.*

Therefore the only questions raised by the petition, notwithstanding its length and the even longer brief filed in support thereof, and which are sought to be presented to this Court, may be stated succinctly as follows:

1. Is an order of transfer pursuant to Title 28, USC, § 1404(a) a *final* order so as to be appealable under Title 28, USC, § 1291?

2. May an order of transfer pursuant to Title 28, USC, § 1404(a) be interpreted as granting an injunction so as to constitute an interlocutory order appealable under Title 28, USC, § 1292(1)?

3. Did the District Court abuse its discretion in entering the order of transfer?

4. Is the decision of the Court of Appeals in conflict with decisions of other Courts of Appeal on the same matter, or probably in conflict with applicable decisions of this Court?

It is submitted that the first three questions were correctly answered below, and further, that there is no conflict with any Court of Appeals on the same question, nor with any applicable decision of this Court.

ARGUMENT

POINT I

An Order of Transfer Under Section 1404(a) of Title 28 USC Is Not A Final Order and Therefore Not Appealable

The applicable provision of the United States Code are as follows:

Section 1404(a) of Title 28, provides:

> "For the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to any other district or division where it might have been brought."

Section 1291 of Title 28, provides:

> "The courts of appeals shall have jurisdiction of appeals from all final decisions of the district courts of the United States, the District Court for the Territory of Alaska, the United States District Court for the District of the Canal Zone, and the District Court of the Virgin Islands, except where a direct review may be had in the Supreme Court."

The order of the District Court at Richmond, transferring this action to the District Court at Chicago, Illinois, did not adjudicate any of the rights of the parties, it merely changed the venue of the action and determined that "for the convenience of the parties and witnesses, in the interest of justice," the trial should be held at Chicago, Illinois, rather than at Richmond, Virginia. The cause of action, if any, asserted by the petitioner against respondent was in no way considered or affected.

The argument that the order of transfer was a final order and therefore appealable was asserted in the Court of Appeals and that Court in its opinion stated (R. 123-4):

> "The motion to dismiss must be granted on the ground that the order transferring the case is not a final order from which an appeal lies under 28 U.S.C. 1291. As was said by the Supreme Court in *Arnold* v. *United States for use of W. B. Guimarin & Co.,* 263 U. S. 427, at p. 434: 'It is well settled that a case may not be brought here by writ of error or appeal in fragments; that to be reviewable a judgment or decree must be not only final but complete, that is, final not only as to all parties, but as to the whole subject matter and as to all the causes of action involved; and that if the judgment or decree be not thus final and complete [fol. 183] the writ of error or appeal must be dismissed for want of jurisdiction. *Hohorst* v. *Hamburg-American Packet Co.,* 148 U. S. 262, 264, 13 S. Ct. 590; *Collins* v. *Miller,* 252 U. S. 364, 370, 40 S. Ct. 347; *Oneida Navigation Corp.* v. *Job,* 252 U. S. 521, 40 S. Ct. 357: and cases therein cited.' * * *". (177 F. 2d. 360, 361, 362)

In addition to the cases cited in the foregoing quotation the Court of Appeals cited other decisions of Courts of Appeals reaching the same conclusion (R. 124). To the same effect, see the very recently published edition of *Moore's Commentary on U. S. Judicial Code,* Sec. 0.03(29), p. 210 (1949 Ed.).

The Court of Appeals also stated in this connection:

> "The general rule is well settled that an order granting or refusing change of venue is not appealable unless expressly made so by statute. 3 C. J. p. 473; 2 *Am. Jur.* 899-900; *Shay* v. *Rinehart & Dennis Co.,* 116 W. Va. 24, 178 S. E. 272, and cases there cited.

> There is no federal statute expressly granting an appeal from such orders; and the federal decisions follow the general rule that they are not appealable. *Cook* v. *Burnley,* 11 Wall. 659, 672; *Kennon* v. *Gilmer,* 131 U. S. 22, 24." (R. 124)

Petitioner suggests that an order of transfer pursuant to Section 1404(a), Title 28 USC, must be appealable because this section of the Code was enacted as a codification of the doctrine of "forum non conveniens" and that *dismissals* of actions resulting from the application of the doctrine were appealable. In its presentation, petitioner erroneously includes within the doctrine of "forum non conveniens" the appealability of final decisions rendered before the enactment of Section 1404(a) *dismissing* (and not *transferring*) complaints under the doctrine.

The doctrine of "forum non conveniens" has been defined as follows:

> "The doctrine of forum non conveniens is not of statutory origin. In Anglo-American law it has been used as a means of declining jurisdiction whenever 'considerations of convenience, efficiency and justice' point to another tribunal than that chose by a litigant as the appropriate tribunal." (*United States v. National City Lines,* 7 F. R. D. 456, 460.)

The above language was adopted in part from an opinion of this Court in *Rogers* v. *Guarantee Trust Co.,* 288 U. S. 123, 131. The doctrine was formulated by the Courts in situations where the plaintiff could pursue his remedy in an alternative and more convenient jurisdiction and where the Court in its discretion could, by *dismissing* the complaint, refuse to entertain jurisdiction leaving the plaintiff to pursue its cause of action in a more convenient forum. *Under the doctrine the Court was without legislative*

authority to transfer the cause of action to another jurisdiction. The action of the Court in *dismissing* a complaint where the doctrine was applied was a final order and gave to the plaintiff a right of appeal. It did not preserve the rights of the plaintiff as against the running of the statute of limitations or any other defense which might exist—and that fact is pointed out in the decisions rendered prior to the adoption of 1404(a) on change of venue.

The ancillary right of appeal, however, is not a part of the doctrine itself. While it may be conceded that the adoption of Section 1404(a) of Title 28 USC, substitutes statutory authority of *transfer* for the earlier nonstatutory doctrine of *dismissal* is a codification *in accordance* with the doctrine of "forum non conveniens", there is no suggestion in the reviser's notes to the new Codes that such codification *was intended to include the right of appeal which was inherent in the final order of dismissal where the doctrine was applied.*

The enactment of Sections 1291 and 1292 of Title 28 USC providing for appeals only in specific instances is a clear expression by Congress of the matters which are appealable and leaves no room for the implication that Congress intended to make orders of transfer (under § 1404a) appealable. The authorities cited by petitioners as to the appealability of an order *dismissing* a complaint under the doctrine of "forum non conveniens", all decided before 1404(a) was enacted, are not in point. These decisions are not in conflict with the order of the Court of Appeals which dismissed petitioner's appeal from the order of transfer.

This same contention relative to the codification of "forum non conveniens" including the unwarranted engrafting on the doctrine of the appealability of orders of *dis-*

missal thereunder was urged by petitioner upon the Court of Appeals. The Court stated:

> "Counsel for plaintiff rely upon decisions permitting appeals from dismissals in application of the principle of forum non conveniens; but these decisions are not in point. A dismissal in application of that or any other principle puts an end to the action and hence is final and appealable. An order transferring it to another district does not end but preserves it as against the running of the statute of limitations and for all other purposes. The notion that 28 USC 1404(a) was a mere codification of existing law relating to forum non conveniens is erroneous. It is perfectly clear that the purpose of this section of the Revised Judicial Code was to grant broadly the power of transfer for the convenience of parties and witnesses, in the interest of justice, whether dismissal under the doctrine of forum non conveniens would have been appropriate or not. See *Ex Parte Collett,* 337 U. S. 55; *Kilpatrick* v. *T. & P. R. Co.,* 337 U. S. 75; *United States* v. *National City Lines,* 337 U. S. 78; and *Amalgamated Association etc.* v. *Southern Bus Lines,* 5 Cir. 172 F. 2d 946, 948. As said by Judge Sibley in the case last cited:
>
> " 'Dismissal for inconvenience is not to be visited except when the choice of forum is a real hardship, or an imposition on the court. But here again we meet the Revision of Title 28, for Section 1404 providing for a change of venue is: "(a) For the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to any other district or division where it might have been brought." * * * Transfer is a less drastic matter than dismissal, for it involves no loss of time or pleading or costs, and no doubt a broader discretion may be exercised in ordering it.' " (R. 124, 177 F. [2] 360, 362)

To the same effect, see *Cinema Amusement Co.* v. *Loew's,* 85 F. Supp. 319 (D. Del.) and *Moore's Commentary on the U. S. Judicial Code,* Sec. 0.03 (29), pages 208-209 (1949 ed.).

The only case which petitioner presents as being in conflict with the decisions of the courts below is that of *Porta* v. *Watts,* 109 F. 2d 966, decided long before the enactment of 1404(a) of the Code. In that case the Court of Appeals for the Tenth Circuit entertained an appeal from the District Court's denial of an application to transfer a bankruptcy proceeding to another district in accordance with Section 118, Chapter 10 of the Chandler Act, 11 USCA 518. The fact that the Court of Appeals in that case entertained an appeal on a question of transfer is explained by the fact that under the bankruptcy laws and particularly Title 11 USCA, § 47, the jurisdiction of the Courts of Appeal for the United States is extended to "proceedings in bankruptcy, *interlocutory or final,* and in controversies arising in proceedings in bankruptcy, to review, affirm, revise or reverse both in matters of law and in matters of fact * * *". Since in bankruptcy matters the Court of Appeals have jurisdiction of appeals from orders, *final or interlocutory,* the decision in *Porta* v. *Watts, Supra,* is not pertinent here where there is no statute permitting appeals from interlocutory orders except injunctions.

There is also some suggestion by the petitioner that the opinion of the Court of Appeals is in conflict with the case of In re *Forstner Chain Corp.,* 177 F. 2d 572. There the appeal was from a ruling or order denying a motion to enter final judgment dismissing a complaint in a patent suit. At the outset of its opinion the Court stated:

> "Under the special circumstances, which we shall summarize below, we hold that the order is a 'final decision.' "

The Court also stated that the order denying the motion to enter final judgment, which occurred after the trial of the case, had the necessary element of finality in that after the entry of the order nothing remained to be done in the case by the trial court. In that connection the Court stated:

> "* * * If the present appeal is entertained by us, it will not be of the piece-meal variety, with the prospect of subsequent appeals from orders or judgments issued by the court below at later stages in the proceeding." (177 F. 2d 572, 575)

The facts of the *Forstner* case are markedly different from those of the instant case in any trial of which the District Court would be called upon to enter any and all appropriate preliminary orders and ultimately a final judgment.

The order of the Court of Appeals dismissing petitioner's appeal from the order of transfer and its opinion thereon are in harmony with the numerous decisions of this Court and other Courts of Appeal holding that a judgment or order to be appealable must be final in that it determines all of the issues of the controversy. The order in this case merely transferring the cause of action from one jurisdiction to another is obviously not a final and appealable order and is not in conflict with any cases cited by petitioner.

It is suggested by petitioner that this Court has not passed upon this question and that *certiorari* should be granted to enable this Court to review this important Federal question. Section 1404(a) of Title 28, USC, enacted June 25, 1948, became effective September 1, 1948 and since that time this section has been invoked by litigants and interpreted many times by trial courts in either granting or denying motions to transfer.

Petitioner refers to the citation of this section "some thirty times" in Shepard's United States Citations (Brief p. 40). Substantially each advance sheet of the Federal Reporter System includes additional cases involving this section. In spite of the fact that litigants throughout the United States have frequently petitioned for the transfer of cases and the adverse parties have opposed such transfers under this section, and in spite of the fact that trial courts have in many instances invoked the statute to order transfer, *this present case is the only one reported in which the appealability of such an order of transfer has been urged.* These facts suggest that, with the exception of petitioner in this case and its counsel, the opinion is uniform throughout the United States that an order of transfer under Section 1404(a) is not appealable. Under these circumstances there does not seem to be any likelihood that other Courts of Appeal will reach a conclusion different from that reached below and there is no disputed question of Federal law requiring the consideration of this Court.

POINT II

An Order of Transfer Under § 1404(a) of Title 28 USC Is Not Appealable Under § 1292(1) of Title 28, As An Interlocutory Injunction

Petitioner suggests that an order of transfer is in effect an injunction restraining plaintiff from pursuing its cause of action in the Eastern District of Virginia and, having the effect, is appealable under Title 28, USC § 1292(1).

This same argument was advanced by petitioner in the Court of Appeals. With respect to this contention the Court stated:

> "We think it equally clear that the order is not appealable under 28 USC 1292 (1) as one granting

> an interlocutory injunction. It should require no discussion to demonstrate that an order transferring or refusing to transfer a case for trial is not one granting or denying an interlocutory injunction and furnishes no ground for the application of the principle applied in the cases of *Enelow* v. *N. Y. Life Ins. Co.*, 293 U. S. 379, and *Ettelson* v. *Metropolitan Life Ins. Co.*, 317 U. S. 188, a principle expressly limited to cases of that sort by the recent decision of the Supreme Court in *City of Morgantown* v. *Equitable Ins. Co.*, 337 U. S. 254. See also opinion of this Court in that case, 169 F. 2d 713." (R. 125, 177 F. 2d 360, 362)

Notwithstanding the foregoing, Petitioner persists in relying upon the cases of *Enelow* v. *N. Y. Life Ins. Co.*, 293 U. S. 379, and *Ettleson* v. *Metropolitan Life Ins. Co.*, 317 U. S. 188, as supporting the argument that an order of transfer is tantamount to an injunction. These cases are not applicable to the present situation. In each of them plaintiff had commenced an action to recover according to the terms of an insurance policy; in each of them the insurance company denied liability, alleging fraud in the procurement of the policy, and moved that the issue of fraud be tried by the court without a jury. The trial court in each case granted the motion and this Court held on review that the rulings thus made were appealable as constituting interlocutory injunctions.

In the present case the complaint charges the respondent with patent infringement. An answer to the complaint has not yet been filed and of course the court has made no segregation of equitable and legal causes of action for purposes of priority in trial. The order entered by the trial court does not enjoin anyone from doing anything but is merely a procedural adjudication based upon the court's factual determination that, for the convenience of the

parties and in the interest of justice, the venue of the action should be transferred.

The decision in *Morgantown* v. *Royal Ins. Co.*, 93 L. ed. Adv. Opinions 1023 (1949) is controlling in this case. There the plaintiff insurance company instituted suit for the reformation of a policy of insurance on the ground of mutual mistake and for a declaration of no liability under the policy. The defendant answered denying mistake and filed a counterclaim to recover on the policy as written. Plaintiff answered the counterclaim alleging the same facts as in its complaint. Defendant thereupon filed a demand for a jury trial under Rule 38(b) of the Federal Rules of Civil Procedure. Plaintiff moved to strike the demand for a jury trial and the Court granted the motion and set the case for trial without a jury. An appeal was taken from the order and on motion of the plaintiff the Court of Appeals dismissed the appeal on the ground that the order was not an appealable order (169 F. 2d 713). This Court granted *certiorari* and the question presented was whether or not the action of the trial court in striking the demand for a jury trial was under the circumstances of that case, appealable as an interlocutory decree granting or refusing an injunction. This Court discussed and distinguished the factual situations presented in the *Enelow* and *Ettelson* cases and said:

> "Whatever the present validity of the analogy to common law practice which supported those cases, it is of no help here. This is not a situation where a 'chancellor' in denying a demand for jury trial can be said to be enjoining a 'judge' who has cognizance of a pending action at law. This is rather a case of a judge making a ruling as to the manner in which he will try one issue in a civil action pending before himself. The fiction of a court with two sides, one of which

> can stay proceedings in the other, *is not applicable where there is no other proceeding in existence to be stayed.* The ruling from which the appeal in this case was prosecuted is an order interlocutory in form and substance. Nothing in the language of the rules or the Judicial Code brings it within the class of appealable decisions, and distinctions from common-law practice which supported our conclusions in the Enelow and Ettelson Cases supply no analogy competent to make an injunction of what in any ordinary understanding of the word is not one." (93 L. ed. Adv. Op. 1023, 1026)

The above language of this Court is peculiarly applicable to the situation presented in this case. The order of transfer does not in effect enjoin a "judge" who has cognizance of a pending action at law. The order of transfer is not an order of a "chancellor" restraining the prosecution of an action at law. *There is in the present case only one cause of action for patent infringement and the prosecution of this cause of action has in no way been enjoined.* Plaintiff-petitioner has the same right to pursue its cause of action after the order of transfer as it had before. The only limitation upon plaintiff-petitioner is that its cause of action must in the interest of justice, if it is desired to be pursued, be conducted in a forum more convenient to the parties than that initially selected by it.

If, as petitioner contends, the entry of an order for transfer pursuant to 28 USC, § 1404(a) constitutes an interlocutory injunction, then it is equally true that the denial of a petition for transfer under this section would constitute the refusal of an injunction and would likewise be appealable under 28 USC, § 1292(1). The adoption of the reasoning advanced by petitioner would result in appeals from all actions taken by trial courts under 28 USC, § 1404(a)

whether the transfer was ordered or not. Such a condition would result in the delay in the trial of many cases, the congestion of the dockets of Courts of Appeal and would contraverse the intention of Congress in the enactment of this section which provides legislative authority for the convenient, speedy and just determination of actions. The language of the Court of Appeals for the Fourth Circuit in *Morgantown* v. *Royal Ins. Co.*, 169 F. 2d 713, 715, is peculiarly apposite to petitioner effort to prefect an abortive appeal in this case:

> "Piecemeal appeals should not be encouraged; and certainly there is no reason why they should be allowed from interlocutory orders merely because a legal counterclaim has been asserted to a suit in equity. Nothing in law or in logic nor any consideration of public policy demand any such extension of the doctrine of the *Enelow* and *Ettelson* cases. *Trials ought not be delayed and appellate dockets crowded by appeals from interlocutory orders directing the course of litigation.* We have given short shrift to such dilatory appeals in other cases. See Bowles v. Commercial Casualty Ins. Co., 4 Cir., 107 F. 2d 169, and cases there cited. There is no reason to encourage them by any such forced interpretation of the statute relating to appeals from interlocutory injunctions as we would have to make to sustain the appeal here."

For the foregoing reasons, it is submitted that an order of transfer under Title 28 U. S. C. A., Section 1404(a) is not appealable under Title 28 U. S. C., Section 1292(1) as an interlocutory injunction.

POINT III

There Was No Abuse of Discretion by the Trial Court in Entering the Order of Transfer

As an alternative to its Petition for Writ of *Certiorari* to the United States Court of Appeals for the Fourth Circuit petitioner has filed a Motion for Leave to File Petition for Writ of Mandamus or Certiorari. It is presumed that this latter motion is directed to the asserted abuse of discretion by the trial court in entering the order of transfer.

The propriety of the order depends upon the factual situation as presented to and thoroughly considered by the trial court. The affidavits of James S. Knowlson (R. 21) and John D. Black (R. 26) contain the factual showing upon which the motion for transfer was based. The affidavits filed on behalf of petitioner opposing the motion are those of August Johnson (R. 61) and Leonard L. Kalish (R. 41). It was upon a consideration of the facts set forth in these affidavits that the order was entered. No purpose would be served by discussing the many cases cited by petitioner wherein other courts *upon different factual situations* exercised their discretion to deny a similar motion.

Petitioner argued in the Court of Appeals that the trial court abused its discretion in entering the order and relative to this matter the Court stated:

> "Finally, we think that, even if the order were appealable, the appeal should be dismissed as presenting no question of substance for our consideration (*City of Morgantown* v. *Royal Ins. Co., supra,* 169 F. 2d at 714). Whether the judge below should have removed the case was a matter resting in his sound discretion (See *Stroud* v. *United States,* 251 U. S. 15, 20; *Kennon* v. *Gilmer, supra*); and there is nothing

in the record to indicate that the discretion was abused. In this posture of the case, there is no reason why we should entertain an appeal lacking in all substance." (R. 125, 177 F(2) 360, 362)

In asserting abuse of discretion by the trial court in the determination of a factual matter petitioner asks this Court to *review* the factual situation and make independent findings of fact. It is settled that this Court will not grant *certiorari* to review evidence for the purpose of factual determinations. This Court said in *United States* vs. *Johnston,* 268 U. S. 220, 227, 69 L. ed. 925, 926:

> "We do not grant a certiorari to review evidence and discuss specific facts."

Relative to writs of mandamus to review the action of a trial court on interlocutory matters this Court has stated:

> "Mandamus is an extraordinary remedy, to be resorted to for the purpose of securing judicial action, not for determining in advance what the action shall be. * * * It may not be resorted to, as the petitioners seek to resort to it here, for the purpose of controlling minor orders made in the conduct of judicial proceedings * * *." (In re Wagner, 249 U. S. 465, 471, 63 L. ed. 709, 713)

In *American Construction Co.* vs. *Jacksonville, T. & K. W. R. Co.,* 148 U. S. 372, 379, 37 L. ed. 486, 489, this Court stated relative to mandamus:

> "Least of all can a writ of mandamus be granted to review a ruling or interlocutory order made in the progress of a cause; for, as observed by Chief Justice Marshall, to do this 'would be a plain evasion of the provision of the act of Congress that final judgments only should be brought before this court for re-exam-

> ination;' would 'introduce the supervising power of this court into a cause while depending in an inferior court, and prematurely to decide it;' would allow an appeal or writ of error upon the same question to be 'repeated, to the great oppression of the parties;' and 'would subvert our whole system of jurisprudence.'"

In addition to the argument that the trial court abused its discretion in determining upon the facts presented that the order of transfer should be granted, petitioner suggests that the trial court abused its discretion in failing to distinguish between "the convenience of parties and witnesses" and "in the interest of justice". In its argument on this point petitioner tacitly concedes that while the order of transfer may have been for the convenience of the parties it is contended however that it is not "in the interest of justice".

In support of this aspect of the argument petitioner asserts that the case law or decisional law enunciated by the courts of the Seventh Circuit is not as favorable to petitioner as the case law or decisional law of the courts of the Fourth Circuit. There is no foundation for this assertion. Petitioner contends that it should be entitled to rely on the decisions of the Fourth Circuit in *Hoeltke* v. *C. M. Kemp Mfg. Co.*, 80 F. (2) 912 and *Chesapeake & Ohio Ry. Co.* v. *Kaltenbach*, 124 F. (2) 375 in respect to which it is said that: "Transfer of this action to a District Court in another circuit, would deprive petitioner of the right to rely on these two last-mentioned decisions * * *" (Brief Page 37). Petitioner quotes extensively from the *Hoeltke* case but significantly omits the following statement dealing with the same question of law:

> "The question was before the Circuit Court of Appeals of the Seventh Circuit in the recent case of Booth vs. Stutz Motor Car Co. of America (C.C.A.

> 7) 56 F (2) 962, and we think that the decision there rendered is eminently sound and just." (80 F (2) 912, 923)

Although petitioner may by the injudicious omission of pertinent portions of an opinion attempt to show a conflict of opinion between the Fourth and Seventh Circuits, there is actually no such conflict.

Petitioner's argument, that the transfer from one Circuit to another was not in the interest of justice, implies quite plainly that petitioner does not believe that justice will be administered to it by the courts of the Seventh Circuit. This argument is based wholly upon the speculation that the present case, not yet at issue, will be finally determined adversely to it in the Seventh Circuit and favorably to it in the Fourth Circuit. No useful purpose will be served by a discussion of the factual situations in the cases decided by the District Courts and the Court of Appeals for the Seventh Circuit which petitioner alleges constitute the decisional law unfavorable to it. Petitioner's argument that because of these earlier decisions, in which it was in no way involved, it cannot get "justice" in the courts of the Seventh Circuit requires no discussion. Indeed, it would be presumptuous for respondent to urge to this Court that petitioner *will* be given a fair trial and *will* secure impartial justice *in the court to which this case has been ordered transferred.*

If, as petitioner asserts, it is not "in the interest of justice" to it to have this case transferred to the courts of the Seventh Circuit and, if, as petitioner apparently pretends to believe, it will not secure justice in the courts of the Seventh Circuit, this Court upon final judgment has the power and authority to review the action of the courts of the Seventh Circuit and will insure that justice is administered impartially.

Petitioner's argument relative to the "interest of justice"

is not based upon any difference in the respective jurisdictions as to the substantive law, such for instance as a difference between applicable statutes of limitations or statutes of frauds. Such an argument cannot be made in this case because the complaint is one for patent infringement and is based upon the Federal patent statutes. Federal law and Federal law alone applies.

We do not and cannot of course concede that the petitioner will be denied justice because of the case law established by the decisions in the Seventh Circuit, but even if some of these decisions may be interpreted by petitioner as being not to its liking, it is of no legal consequence upon a motion to transfer. Petitioner's argument is in effect an assertion of prejudice or disqualification *on the part of all of the judges of the Seventh Circuit.* Such an assertion of prejudice cannot validly be based upon the fact that a judge, or the Judges thereof, have previously made adverse rulings. In *Ex parte American Steel Barrel Co.,* 230 U. S. 35, this Court stated:

> "The basis of the disqualification is that 'personal bias or prejudice' exists, by reason of which the judge is unable to impartially exercise his functions in the particular case. It is a provision obviously not applicable save in those rare instances in which the affiant is able to state facts which tend to show not merely adverse rulings already made, which may be right or wrong, *but facts and reasons which tend to show personal bias or prejudice.* It was never intended to enable a discontented litigant to oust a judge because of adverse rulings made, for such rulings are reviewable otherwise, but to prevent his future action in the pending cause. * * * " (pp. 43-44)

Petitioner certainly cannot come within one of these rare exceptions since it was in no way involved in any of the

decisions complained of and the record does not show that it has otherwise established that it was ever involved in any litigation in any of the courts of the Seventh Circuit. Its argument is tantamount to saying that because of its preference for the decisional or case law of the Fourth Circuit it has a vested right to try the instant case in a District Court of that Circuit. As indicated above, this is an unwarranted attack upon the integrity of the Judges of the Seventh Circuit and completely disregards the apparent intent of Congress in enacting 28 U.S.C., Sec. 1404(a) which provides for transfer of causes of action from one jurisdiction to another.

It appears, therefore, that there was no abuse of discretion in the factual determination made by the trial court and upon which the order of transfer was based.

CONCLUSION

In conclusion it is respectfully submitted:

(1) that the order of the District Court of July 29, 1949, transferring the case pursuant to the provisions of Title 28 U. S. C., Section 1404(a), was not a *final* order and therefore not appealable under Title 28 U. S. C., Section 1291, and there is no error in the decision of the Circuit Court of Appeals in so holding (R. 123);

(2) that the order of the District Court of July 29, 1949, transferring the case pursuant to the provisions of Title 28 U. S. C., Section 1404(a), may not be interpreted as granting an injunction so as to become an *interlocutory* order appealable under Title 28 U. S. C., Section 1292(1), and there is no error in the decision of the Circuit Court of Appeals in so holding (R. 125);

(3) that the order of the District Court of July 29, 1949, transferring the case pursuant to the provisions of Title 28 U. S. C., Section 1404(a), involved an exercise

of discretion, review of which may not be had on appeal in the absence of abuse, of which there was no showing, and there is no error in the decision of the Circuit Court of Appeals in so holding (R. 125); and

(4) that there has been no showing that the decision of the Court of Appeals is in conflict with decisions of other Courts of Appeal of the United States on the question involved, or that such decision is probably in conflict with the applicable decisions of this Honorable Court.

The petition for a writ of *certiorari* and, in the alternative, a motion for leave to file a petition for a writ of *mandamus* or *certiorari,* should therefore be denied.

Respectfully submitted,

Richmond, Va.
January 18, 1950

WINSTON, STRAWN, SHAW & BLACK
First National Bank Building
Chicago, Illinois

HINKEL, HORTON, AHLBERG, HANSMANN & WUPPER
2300 Board of Trade Building
LaSalle Street & Jackson Boulevard
Chicago, Illinois

HUNTON, WILLIAMS, ANDERSON, GAY & MOORE
Electric Building
Richmond, Virginia
Counsel for Respondent

JOHN D. BLACK
ELWOOD HANSMANN
THOMAS B. GAY
Of Counsel

Index of Subject Matter

pages

Finding of Fact (in earlier suit between the parties at bar) is that respondent has its *principal place of business in the Eastern District of Virginia*..... 1

Appealability of District Court's "Final Order Transferring Venue" (R.p. 72)..... 2

Cohen vs. *Beneficial* 337 U.S. 541..... 2

Magnetic Engineering & Mfg. Co. vs. *Dings Mfg. Co.* F.2d (84 USPQ 105)..... 3

Respondent's Brief misrepresents petitioner's position..... 5

Companion case of *Alemite* vs. *Jiffy* now before this Court on a Petition for Writ of Certiorari filed January 14, 1950..... 5

Conclusion..... 6

Table of Cases

Alemite Corp. vs. *Grease-Rite Corp.* Equity No. 9812 (DC ND Ill.)..... 5

Alemite Co. vs. *Jiffy Lubricator Co.* 176 F.2d 444 (CCA-8) No. 543 of the October Term, 1949 of this Court..... 6

Cohen vs. *Beneficial Industrial Loan Corp.* 337 U.S. 541 (93 L.Ed 1221, 1226)..... 1

Lincoln Engineering Co. vs. *Stewart-Warner Corp.* 91 F.2d 757 (CCA-7)..... 5

Magnetic Engineering & Mfg. Co. vs. *Dings Mfg. Co.* F.2d (84 USPQ 105, 109, 110)..... 3

Stewart-Warner Corp. vs. *Jiffy Lubricator Co.* 81 F.2d 786 (CCA-8)..... 1

Stewart-Warner Corp. vs. *Lincoln Engineering Co.* 15 F. Supp. 571 (DC ND Ill.)..... 5

Stewart-Warner Corp. vs. *Lincoln Engineering Co.* 16 F. Supp. 778 (DC ND Ill.)..... 5

Stewart-Warner Corp. vs. *Lincoln Engineering Co.* 31 USPQ 195 (DC ND Ill.)..... 5

Statutes

Section 1291 of Title 28 of the United States Code..... 2

Section 1292 of Title 28 of the United States Code..... 2

Section 1404-a of Title 28 of the United States Code..... 5

Petitioner's Reply Brief

Although respondent now claims that* its entire business is transacted in Chicago, we should nevertheless like to call the Court's attention to a *Finding of Fact* wholly inconsistent with its present contention, to be found in the Record filed in this Court in an earlier suit between the same parties.

We refer to the *Findings of Fact* appearing on pages 35 and 42 of *Volume I* of the printed Transcript of Record filed in this Court on June 13, 1936 on the Stewart-Warner Corporation's Petition for Writ of Certiorari to review the decision in *Stewart-Warner Corporation* vs. *Jiffy Lubricator Co.*, 81 F.2d 786 (CCA-8), which Petition for Writ of Certiorari was docketed in this Court as No. 114 of the October Term 1936 (certiorari having been denied at 299 U.S. 544):

> "Finding of Fact and Conclusions of Law of District Court."
>
> "The Court having considered the files, records and proceedings herein, the evidence produced at the trial of the above entitled action and the arguments of counsel, now makes and files its Findings of Fact and Conclusions of Law as follows:
>
> "Findings of Fact"
>
> "I. Plaintiff, **Stewart-Warner Corporation**†, is a corporation organized and existing under and by virtue of the laws of the State of Virginia, a citizen of Virginia, a resident of and **having its principal place of business at Richmond, Virginia**†, and a regular and established place of business in Chicago, Cook County, State of Illinois." (R.p. 35)
>
> . . . . . .
>
> "Dated March 18th, 1935." "ANDREW MILLER
> United States District Judge"
>
> "Endorsed on the face as follows: Filed Mar. 18, 1935. J. A. Montgomery, Clerk." (R.p.42)

* while it is admittedly a Virginia corporation and good service was admittedly had upon it in the Eastern District of Virginia

† emphasis supplied.

Appealability of District Court's "Final Order Transferring Venue" (R.p. 72)

In the case of *Cohen* vs. *Beneficial* (337 U.S. 541) decided no longer ago than the close of last term, this Court had to deal with the appealable character of action taken under a statute requiring the plaintiff to give a bond as a condition of maintaining suit. The case is too recent to need recapitulation now, but it establishes that despite the literal meaning of the Statute*, this Court has construed this Statute* practically rather than technically, allowing immediate review of that "small class" of cases

> "which finally determine claims of right separable from, and collateral to, rights asserted in the action, too important to be denied review and too independent of the cause itself to require that appellate consideration be deferred until the whole case is adjudicated. The Court has long given this provision of the statute this practical rather than a technical construction." (citing cases)

The theory of the decision is found in the preceding paragraph of this Court's aforesaid opinion. The order held appealable, said this Court, was no part of, no tentative step toward, that final judgment which should ultimately dispose of the merits of the whole case. Moreover, when that is reached

> "it will be too late effectively to review"

the order under consideration

> "and the rights conferred by the statute"

i.e., the statute requiring the plaintiff to give bond

> "will have been lost, probably irrevocably".

* Sections 1291 and 1292 of Title 28 of the U.S. Code

And in concluding, the Court held that the order under consideration was:

> "appealable because it is a final disposition of a claimed right which is not an ingredient of the cause of action and does not require consideration with it".

The analogy between the *Cohen* and the present case is clear and perfect. In the case at bar the petitioner was, as Cohen might have been, finally turned out of Court. Petitioner at bar was sent to another jurisdiction and the harm done can be corrected by no subsequent review of this case. We submit that the right—to remain where he lawfully was—is, in the language of the *Cohen* case,

> "too important to be denied review and too independent of the cause itself to require that appellate consideration be deferred until the whole case is adjudicated".

While in its recent (January 4, 1950) decision in the case of *Magnetic Engineering & Mfg. Co.* vs. *Dings Mfg. Co.*, F.2d (84 USPQ 105), the Court of Appeals for the 2nd Circuit undoubtedly agreed with the 4th Circuit's decision in the case at bar, yet we call attention to the dissenting opinion in that case, as we believe it is in harmony with this Court's decision in the *Cohen* vs. *Beneficial Industrial Loan Corp.* case, *supra,* and because such dissenting opinion also shows the complications and impasse which can result from a failure to give immediate appellate review to an order transferring a case *to a different Circuit.* For the convenience of the Court we therefore quote the following from the dissenting opinion in the *Magnetic* vs. *Dings,* case, supra:

> ". . Congress, when it recently substituted a transfer order for an order of dismissal previously used (under the forum non conveniens doctrine) in cases like this, almost surely did not plan such a result, i.e., I think that Congress did not have in mind that the transfer order would be interlocutory and non-appealable. I think, therefore, that a sense of justice should

prompt us to grant relief, if possible, by way of mandamus. For if, on the facts here, the transfer order was improper, plaintiff may be seriously hurt, should he be obliged to wait, for a vacation of reversal of that order, until the completion of a trial in Wisconsin. Indeed, paradoxically, if he must thus wait, the hurt to him, caused by the transfer, will be wholly irremediable."

. . . . . .

"I grant that a court's sense of justice should not induce it to ignore limitations on its power imposed by statute or by precedents so well established that it would be improper to alter them judicially. But I see no such barriers here. I find nothing in the legislative history or wording of the statute as to writs of mandamus nor in any decisions construing that statute, which compels the undesirable conclusion at which my colleagues have apparently arrived."

"There is one sentence in my colleagues' opinion which perhaps intimates that, were the impropriety of the transfer order sufficiently glaring, we could issue the writ, but that, absent such glaring facts, it is much to be preferred that the Seventh Circuit consider whether a writ should issue. Even if this restricted interpretation of my colleagues' opinion is correct, I disagree. For I perceive no reason why the Seventh Circuit can better decide the issue than can we. After all, the removal order was made by a district court within this Circuit. And, if the Seventh Circuit does issue a writ, the situation will become involved: That Circuit Court will direct the district court in Wisconsin to re-transfer the case to the court below. But the court below will not be subject to a re-transfer order entered by the Seventh Circuit, and might, refusing to comply with that order, again transfer the case to Wisconsin. Perhaps, in those circumstances, we would intervene, and, probably feeling obliged to follow the Seventh Circuit's determination, would by mandamus, direct the court below to hear the case. Such is the complicated procedure which my colleagues' decision opens up as a possibility. I fail to understand why we should require such an involved procedure instead of ourselves determining at once whether the order of the lower court was within its discretion. We can do so now, for all the facts bearing on the propriety of that order are in the record now before us."

Respondent's brief misrepresents petitioner's position

Under *Question 3* of the Petition and corresponding *Argument-Point 4* of the Brief filed in support thereof, petitioner has taken the position that where the decisional law or case-law of the Circuit to which the movant under 28 U.S.C. 1404-a seeks to transfer venue is distinctly more favorable to the movant and correspondingly less favorable to the plaintiff opposing the transfer, such transfer is "not in the interest of justice";—petitioner's uncontroverted Johnson affidavit (R.pp. 61-64) and the arguments of respondent's counsel in the companion case (R.pp. 64-71; especially pp. 68-71) conclusively showing that, *in respondent's view,* the decisional law* in the 7th Circuit is distinctly more favorable to respondent and less favorable to petitioner.

Under *Point III* of respondent's brief, counsel misrepresent petitioner's position on this Point as a charge of prejudice on the part of or disqualification of the Judges of the 7th Circuit and then equally fallaciously suggests that this is an unwarranted attack upon the Judges of that Circuit. Petitioner, of course, has never even intimated any such thing. The intimation would be absurd from any point of view. To impute it to petitioner is unwarranted and unfair.

Petitioner's position is simply this: if the law is different in the several Districts or Circuits in which this action might be brought, Congress by adopting Section 1404(a) never intended to force petitioner to trial in a District or Circuit in which the law* is unfavorable to petitioner and favorable to respondent.

Companion case of Alemite vs. Jiffy now before this Court on a Petition for Writ of Certiorari filed January 14, 1950

On page 2 of the respondent's Brief in opposition, respondent alludes to the fact that in the companion case of

* *Stewart-Warner* vs. *Lincoln* 15 F.Supp. 571 and 16 F.Supp. 778 and 31 USPQ 195, and *Lincoln* vs. *Stewart-Warner* 91 F.2d 757 (CCA-7), and *Alemite Corporation* vs. *Grease-Rite Corporation,* Equity No. 9812 (DC ND Ill)

Alemite Co. vs. *Jiffy Lubricator Co.* 176 F.2d 444 (CA-8), petitioner's patent here in suit was held invalid.

Attention is called to the fact that on January 14, 1950, a Petition for Writ of Certiorari and Brief in support thereof were filed in this Court in the aforesaid companion case and the case was docketed as No. 543 of the October Term, 1949.

Conclusion

In conclusion it is respectfully submitted that this case is one in which a writ of certiorari should be granted.

Respectfully submitted,

LEONARD L. KALISH,
LITTLETON M. WICKHAM,
GUY B. HAZELGROVE,
WILLIAMS, MULLEN & HAZELGROVE,
attorneys for petitioner

[redacted]